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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205023
Party	Defendant San Pasqual Casino Development Group Inc..
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VIEJAS BAND OF KUMEYAAY INDIANS,)	
)	
Opposer)	Opposition No. 91205023
)	
v.)	
)	
SAN PASQUAL CASINO DEVELOPMENT)	
GROUP, INC.,)	
)	
Applicant.)	

APPLICANT’S MOTION TO DISMISS

Pursuant to Fed. R. Civ. P. 12(b)(1) and 12(b)(6) and 37 CFR § 2.116, Applicant San Pasqual Casino Development Group, Inc. (“SPCDG”) hereby moves to dismiss the Notices of Opposition (“Opposition”) filed by Opposer Viejas Band of Kumeyaay Indians (“Viejas”) for the following reasons:

1. SPCDG is an arm of a federally recognized Indian tribe and accordingly has tribal sovereign immunity such that the Board lacks subject matter jurisdiction to hear the instant Opposition;
2. Viejas has failed to adequately plead sufficient facts to allege standing to maintain the instant Opposition; and
3. Viejas has failed to adequately plead sufficient facts to set forth a ground for denying SPCDG’s registrations for the PINCH YOURSELF mark.

FACTS

Federal law recognizes Indian tribes as distinct, sovereign governments immune from suit under the doctrine of tribal sovereign immunity. The doctrine is based on a policy of protecting tribal sovereignty and promoting tribal self-governance. Tribal sovereign immunity applies as long as it has not been unequivocally waived by the tribe or abrogated by Congress.

San Pasqual Casino Development Group (“SPCDG”) is a wholly-owned, tribally chartered corporation formed under the laws of the San Pasqual Band of Mission Indians, a federally recognized Indian tribe. SPCDG is exclusively responsible for the operation, management, and development of Valley View Casino, a San Diego-area casino. The San Pasqual Band of Mission Indians owns Valley View Casino. SPCDG is an authorized agency of the San Pasqual Band of Mission Indians and is an arm of the tribe. SPCDG has invested significant capital and time in Valley View Casino, including through the creation, protection, and enforcement of intellectual property such as the PINCH YOURSELF mark.

The Viejas Band of Kumeyaay Indians (“Viejas”) owns, operates, directs, controls, and/or is involved in the day-to-day operations of a competing casino, Viejas Casino. (*See* Pico Decl. in Supp. of Mot. to Dismiss Filed by Specially-Appearing D.s, Viejas Band of Kumeyaay Indians & Its Officers ¶ 4, *San Pasqual Casino Dev. Group, Inc. v. Viejas Band of Kumeyaay Indians et al.*, No. 11CV1983 JAH POR (S.D. Cal. Nov. 7, 2011) (“Exhibit A”).) Beginning in early 2011, Viejas engaged in a concerted effort to misappropriate SPCDG’s intellectual property and trade on SPCDG’s goodwill, including through the use of the PINCH YOURSELF mark.

On August 29, 2011, SPCDG filed a complaint in the Southern District of California

against Viejas, alleging, among other things, infringement of the PINCH YOURSELF mark. (See Compl. for Trademark Infringement, Copyright Infringement, & Unfair Competition, *San Pasqual Casino Dev. Group Inc. v. Viejas Band of Kumeyaay Indians*, No. ‘11CV1983 JAH POR (S.D. Cal. Aug. 29, 2011) (“Exhibit B”).) Viejas resisted, filing a motion to dismiss alleging that the court lacked subject matter jurisdiction to resolve disputes between different Indian nations on the basis of tribal sovereign immunity. (See Memo. of P. & A. in Supp. of Mot. to Dismiss Filed by Specially-Appearing Defs., *Viejas Band of Kumeyaay Indians & Its Officers, San Pasqual Casino Dev. Group, Inc. v. Viejas Band of Kumeyaay Indians et al.*, No. 11CV1983 JAH POR (S.D. Cal. Nov. 7, 2011) (“Exhibit C”).) Viejas also filed a Declaration by the Vice President of Marketing for Viejas Casino, Vince Manfredi, claiming that it was no longer using the PINCH YOURSELF mark. (See Manfredi Decl. in Supp. of Def.’s *Ex Parte* Application for Order Staying or Continuing the Hr’g on Pl.’s Mot. for Prelim. Inj. Pending Determination of Subject Matter Jurisdiction, *San Pasqual Casino Dev. Group, Inc. v. Viejas Band of Kumeyaay Indians*, No. 11CV1983 JAH POR (S.D. Cal. Nov. 8, 2011) (“Exhibit D”).) In view of the Manfredi Declaration indicating cessation of use of the PINCH YOURSELF mark and the other intellectual property involved in the lawsuit, SPCDG dismissed the suit without prejudice on December 14, 2011. (Notice of Voluntary Dismissal Pursuant to Fed. R. Civ. P. 41, *San Pasqual Casino Dev. Group, Inc. v. Viejas Band of Kumeyaay Indians et al.*, No. 11CV1983 JAH POR (S.D. Cal. Dec. 14, 2011) (“Exhibit E”).)

Now, after asserting sovereign immunity against SPCDG and claiming to no longer use the PINCH YOURSELF mark, Viejas filed the present Opposition against SPCDG, a tribal arm, claiming that Viejas will be damaged if the PINCH YOURSELF mark is allowed to register.

However, Viejas has failed allege any damage recognized by the Trademark Act, has failed to state a claim, and, more importantly, has chosen to wholly ignore SPCDG's *own* sovereignty. Accordingly, this Motion to Dismiss follows.

ARGUMENT

I. Viejas' Opposition Should be Dismissed for a Lack of Subject Matter Jurisdiction on the Basis of Tribal Sovereign Immunity

a. Motions to Dismiss for Lack of Subject Matter Jurisdiction

"A motion to dismiss for lack of subject matter jurisdiction may either attack the allegations of the complaint or may be made as a 'speaking motion' attacking the existence of subject matter jurisdiction in fact." *Thornhill Publ'g Co. v. Gen. Tel. & Elec.*, 594 F.2d 730, 733 (9th Cir. 1979). "Unlike a Rule 12(b)(6) motion, a Rule 12(b)(1) motion can attack the substance of a complaint's jurisdictional allegations despite their formal sufficiency, and in doing so rely on affidavits or any other evidence properly before the court." *St. Clair v. City of Chico*, 880 F.2d 199, 201 (9th Cir. 1989). The existence of disputed material facts does not prevent the Board from evaluating the merits of the jurisdictional claims. *See id.*

Where a Rule 12(b)(1) motion is brought as a "speaking motion," the Board can consider extrinsic evidence on whether jurisdiction exists and may resolve factual disputes if necessary. *See Thornhill*, 594 F.2d at 733. No presumption of truthfulness attaches to allegations in the opposition and the Board must presume it lacks jurisdiction until the opponent meets its burden of showing jurisdiction exists. *See Kokkonen v. Guardian Life Ins. Co. of Am.*, 511 U.S. 375, 377 (1994); *Stock W., Inc. v. Confederated Tribes*, 873 F.2d 1221, 1225 (9th Cir. 1989).

Objections to subject matter jurisdiction based on sovereign immunity can be asserted at any time, and may be asserted *sua sponte* by the Board. *See Pitt River Home & Agric. Coop.*

Assoc. v. United States, 30 F.2d 1088, 1100 (9th Cir. 1994).

b. Tribal Sovereign Immunity Bars Administrative Proceedings Against Unconsenting Tribes and Tribal Arms

Tribal sovereign immunity bars suit against tribes and their arms, which include casinos. *See, e.g., Allen v. Gold Country Casino*, 464 F.3d 1044, 1046 (9th Cir. 2006). Where tribal sovereign immunity exists, it must either be waived or abrogated for a suit to proceed. *E.g., Okla. Tax Comm’n v. Citizen Band Potawatomi Indian Tribe of Okla. (Potawatomi)*, 498 U.S. 505, 509 (1991). “There is a strong presumption against waiver of tribal sovereign immunity.” *Demontiney v. U.S. ex rel. Dep’t of Interior, Bureau of Indian Affairs*, 255 F.3d 801, 811 (9th Cir. 2001). Any waiver of sovereign immunity by a tribe must be unequivocally expressed, not implied. *Kescoli v. Babbitt*, 101 F.3d 1304, 1310 (9th Cir. 1996); *Quileute Indian Tribe v. Babbitt*, 18 F.3d 1456, 1459 (9th Cir. 1994). Further, any congressional abrogation of sovereign immunity must be “unequivocally expressed” in “explicit legislation,” not implied. *Krystal Energy Co. v. Navajo Nation*, 357 F.3d 1055, 1056 (9th Cir. 2003).

With respect to the Lanham Act, Congress has not abrogated tribal sovereign immunity. *See, e.g., Multimedia Games, Inc. v. WLGC Acquisition Corp.*, 214 F. Supp. 2d 1131, 1135 (N.D. Okla. 2001). Moreover, participation in the federal trademark system alone does not waive sovereign immunity. *Cf. Bd. of Regents of the Univ. of Wisc. Sys. v. Phoenix Software Int’l, Inc.*, 565 F. Supp. 2d 1007, 1013-14 (W.D. Wisc. 2008), *rev’d on other grounds*, 653 F.3d 448 (7th Cir. 2011).

Although not coextensive with state sovereign immunity, *see, e.g., Kiowa Tribe of Oklahoma v. Manufacturing Technologies Inc.*, 523 U.S. 751 (1998), tribal sovereign immunity bears a number of similarities to state sovereign immunity. For example, “[t]he preeminent

purpose of state sovereign immunity is to accord States the dignity that is consistent with their status as sovereign entities.” *Fed. Mar. Comm’n v. S. Carol. State Ports Auth.*, 535 U.S. 743, 760 (2002). Similarly, the purpose of tribal sovereign immunity is to promote Indian self-government, self-sufficiency, and economic development. *Potowatomi*, 498 U.S. at 510 (quoting *California v. Cabazon Band of Mission Indians*, 480 U.S. 202, 216 (1987)).

Given the similarities between state and tribal sovereign immunity, *Federal Maritime Commission* is instructive. There, the Supreme Court held that state sovereign immunity barred the Federal Maritime Commission (FMC), an administrative agency, from adjudicating complaints filed by a private party against a non-consenting state. *Fed. Mar. Comm’n*, 535 U.S. at 760.

In so holding, the Court examined FMC adjudications and found that they “walk[], talk[], and squawk[]” like a lawsuit such that application of sovereign immunity was appropriate. *See Fed. Mar. Comm’n*, 535 U.S. at 757-58. In particular, the rules governing pleadings in both types of proceedings were similar; discovery largely mirrored that in federal civil litigation; the ALJ’s role was similar to an Article III judge; and the FMC’s Rules of Practice and Procedure looked to the Federal Rules of Civil Procedure to fill in any gaps. *Id.* at 757-60. These “strong similarities,” along with state sovereign immunity’s purpose of according states the dignity consistent with their status as sovereign entities, led to the conclusion that the FMC was barred from adjudicating the complaint. *Id.* at 760.

Like an FMC adjudication, an opposition before the TTAB “walks, talks, and squawks” like a lawsuit, making an extension of sovereign immunity appropriate. *See TBMP 102.03* (“An inter partes proceeding before the Board is similar to a civil action in federal district court.”).

The TBMP and controlling CFRs sets forth similar rules for pleadings as those found under the FRCPs. *See, e.g.*, TBMP 309.03; 37 CFR § 2.101(b). Discovery in an opposition bears many similarities to discovery in federal civil litigation, including the rules for initial disclosures and the rules governing depositions. *See* TBMP 401.02; TBMP 404.02; *see also* 37 C.F.R. § 2.120(a)(1) (“Wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition . . . proceedings . . .”). The Board’s ALJs, after reviewing the parties’ arguments, make determinations based in law as to whether a mark will be permitted to register and issue orders setting forth those determinations, similar to functions performed by an Article III judge. Further, the TBMP expressly states that the Federal Rules of Civil Procedure and the Federal Rules of Evidence apply to opposition proceedings. *See* TBMP 101.02 .

These similarities, along with the purposes of affording autonomy to Indian tribes and their arms, indicate that under the rationale of *Federal Maritime Commission*, the Board is barred from adjudicating Viejas’s Opposition. *Cf. Bd. of Regents of Univ. of Wisc. Sys. v. Phoenix Intern. Software, Inc.*, 653 F.3d 448, 464 (7th Cir. 2011) (stating that under *Federal Maritime Commission*, the State of Wisconsin could have “refused to participate” in a TTAB cancellation proceeding filed against the State); *Puerto Rico Ports Auth. v. Fed. Mar. Comm’n*, 531 F.3d 868 (D.D.C. 2008) (applying *Federal Maritime Commission* to find the FMC barred from adjudicating a complaint filed against an arm of Puerto Rico, a commonwealth entitled to sovereign immunity).

Moreover, “[a]n opposition is a proceeding in which the plaintiff seeks to prevent issuance of a registration, in whole or in part, of a mark on the Principal Register.” TBMP

102.02. An opposition is filed only after the Trademark Office has independently investigated and determined that the mark can register. *See* TBMP 306 (oppositions filed after publication in the *Official Gazette*). The “plaintiff” in an opposition is the opposer, and the “defendant” is the respondent. 37 CFR § 2.116. And the opponent, or plaintiff, in an opposition must itself be the “damaged” party. 15 U.S.C. § 1063(a).

Thus, an opposition is purely a dispute between the parties, independent of the Trademark Office’s determination of registerability, and does not invoke any superior sovereign powers of the United States. *Compare United States v. Yakima Tribal Court*, 806 F.2d 853, 861 (9th Cir. 1986) (holding U.S. government’s superior sovereign powers overrode Indian tribe’s sovereign immunity such that tribal sovereign immunity did not bar suit by the U.S. government against the tribe); *Quileute Indian Tribe v. Babbitt*, 18 F.3d 1456, 1459 (9th Cir. 1994) (noting that in an administrative proceeding brought by the U.S. government against an Indian tribe, “tribal immunity is generally not asserted . . . because tribes cannot impose sovereign immunity to bar the federal government from exercising its trust obligations”). Because the Opposition is purely a dispute between two co-equal sovereigns, rather than a dispute brought by a superior sovereign against a tribe, tribal sovereign immunity may be properly applied.

Because SPCDG is a tribal arm, SPCDG has tribal sovereign immunity. SPCDG has not waived its immunity, nor has Congress abrogated its immunity. Accordingly, SPCDG is a non-consenting sovereign to this Opposition, which under *Federal Maritime Commission* and its progeny is an administrative adjudication. Tribal sovereign immunity bars the TTAB from

adjudicating this Opposition, and therefore, the Opposition must be dismissed.¹

II. Viejas' Opposition Should be Dismissed for a Lack of Standing

Under 15 U.S.C. § 1063(a), “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register” can oppose registration of the mark. The term “damage” in § 1063(a) specifically concerns an opponent’s standing to file an opposition. *Ritchie v. Simpson*, 50 USPQ2d 1023, 1025 n.2 (Fed. Cir. 1999). At the pleading stage, an opponent must allege facts sufficient to show a “real interest” in the proceeding, and a “reasonable basis” for its belief that it would suffer damage if the mark at issue is registered. *Id.* at 1025. To plead a “real interest,” an opponent must allege a “direct and personal stake” in the outcome of the proceeding. *Id.* at 1026. Further, the opponent’s allegations in support of its belief of damage must have a reasonable basis “in fact.” *Id.* at 1027. “The purpose of the standing requirement is ‘to prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner or opposer, is no more than a mere intermeddler.’” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012) (quoting *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028-29, 213 USPQ 185 (CCPA 1982)).

In opposing both U.S. Trademark Appl. Ser. No. 85/394,805 (“the ‘805 Application”) and U.S. Trademark Appl. Ser. No. 85/394,796 (“the ‘796 Application”), Viejas claims that if SPCDG were granted registration of PINCH YOURSELF, that registration “would be a source of damage and injury to Opposer.” (‘805 Opp’n ¶ 8; ‘796 Opp’n ¶ 8.) However, nowhere does Viejas claim that it *is* using the PINCH YOURSELF mark or a confusingly similar mark. Rather, Viejas claims that it “*has* used”—past tense—the PINCH YOURSELF mark. (‘805

¹ Viejas has taken the position in prior litigation between the parties that tribal sovereign immunity exists in a purely commercial dispute between two tribal sovereigns. (See Exhibit C.)

Opp'n ¶ 3; '796 Opp'n ¶ 3.)

With no current use or planned future use of the mark or a confusingly similar mark, it is unclear how Viejas has a “direct personal stake” in the outcome of the proceeding sufficient to establish the required “real interest” in the proceeding. Rather, Viejas is a mere intermeddler, the precise type of party that the “real interest” requirement is intended to prevent. *See Ritchie*, 50 USPQ2d at 1025; *see also Drew Estate Holding Co., LLC v. Fantasia Distrib. Inc.*, No. 11-21900-CIV, 2012 WL 864659 (S.D. Fla. Mar. 13, 2012) (granting motion to dismiss where plaintiff failed to allege that it was currently using the contested marks or similar marks and failed to allege in good faith that it could use any of the contested marks).

Similarly, with no current use or planned future use of the mark or a confusingly similar mark, it is unclear how Viejas has established a reasonable basis in fact for its belief of damage. Were PINCH YOURSELF to register, Viejas would not be harmed simply because it used the mark *in the past*. However, § 1063(a) does not permit opposition by any person who believes he *was* damaged; it only permits opposition by a person who believes he *would be* damaged.

Nor can standing be found by virtue of Viejas' allegations that the PINCH YOURSELF mark is descriptive ('805 Opp'n ¶ 4; '796 Opp'n ¶ 4). An opposer need not have proprietary rights in a mark *if* the opposer is engaged in the sale of the same or related products or services *and* needs the mark to effectively compete in its business, for example, if the mark is descriptive.² *See, e.g., Jewelers Vigilance Comm. Inc. v. Ullenberg Corp.*, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987); *see also DeWalt, Inc. v. Magna Power Tool Corp.*, 129 USPQ 275, 280 (CCPA 1961) (damage presumed or inferred where “mark sought to be registered is descriptive

² SPCDG disputes that PINCH YOURSELF is merely descriptive and believes that at a minimum, the mark is suggestive. However, the alleged descriptiveness of the PINCH YOURSELF mark is discussed here at some length for the purposes of establishing Viejas' failure to sufficiently plead the required damage.

of the goods and the opposer . . . is one who has a sufficient interest in using the term in its business”). However, where the mark is *not* descriptive, damage is not presumed, as an opposer does not have a sufficient interest in using a non-descriptive mark in its business. *DeWalt*, 129 USPQ at 280; *A. B. Dick Co. v. Whitin Machine Works*, 118 USPQ 380, 380-81 (CCPA 1958) (finding no damage and dismissing opposition where competitor was unable to establish descriptiveness of the mark at issue).

Here, Viejas claims to provide “similar services, including restaurant and bar services” (‘805 Opp’n ¶ 2) and “casino gaming and entertainment services” (‘796 Opp’n ¶ 2). However, the term PINCH YOURSELF is demonstrably *not* descriptive of the services set forth in either of SPCDG’s Applications, and Viejas has not claimed a need to use the mark to compete.

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature, or purpose of the goods or services it identifies with a “degree of particularity.” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *Plus Prods. v. Med. Modalities Assocs., Inc.*, 211 USPQ 1199, 1204-05 (TTAB 1981). Whether a mark is merely descriptive is considered in relation to the identified goods and services, not in the abstract. *See, e.g., In re Polo Int’l Inc.*, 51 USPQ2d 1061 (TTAB 1999); *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) (“Whether consumers could guess what the product is from consideration of the mark alone is not the test”).

Viejas’ allegations that PINCH YOURSELF is merely descriptive are, in their entirety, as follows:

The phrase “PINCH YOURSELF” is merely descriptive of “restaurant; hotel, bar and restaurant services; hotel accommodation services; hotel services for preferred customers; hotel, restaurant and catering services; bar and restaurant services; café and restaurant services; and restaurant services.”

(‘805 Opp’n ¶ 4), and:

The phrase “PINCH YOURSELF” is merely descriptive of “entertainment services, namely, casino gaming; gaming services in the nature of casino gaming; casino services; and entertainment services, namely, live appearances by a professional entertainer.”

(‘796 Opp’n ¶ 4).

On its face, the term PINCH YOURSELF does not immediately convey knowledge of *any* significant quality, characteristic, function, feature, or purpose with a degree of particularity of the restaurant, hotel, bar, and catering services listed in the ‘805 Application, nor does it do so for the entertainment, casino, and gaming services listed in the ‘796 Application. And nowhere does Viejas identify what purported significant quality, characteristic, function, feature, or purpose of the listed services in either Application is immediately conveyed with a degree of particularity by the term PINCH YOURSELF.

Even assuming *arguendo* that PINCH YOURSELF *were* to immediately convey knowledge of some significant quality, characteristic, function, feature, or purpose of SPCDG’s services—an assumption that is necessary here considering Viejas’ failure to identify anything that is immediately conveyed by the mark—“PINCH YOURSELF” has multiple connotations as applied to SPCDG’s services and therefore is a double entendre. *See, e.g., In re Computer Business Sys. Group*, 229 USPQ 859, 859-60 (TTAB 1985) (“When a term or phrase, as applied to the goods or services in question, possesses double meaning; suggests something more than a characteristic of the goods; and functions as more than a mere description of the goods; it is not merely descriptive of the goods and may be registered under the Trademark Act.”); TMEP 1213.05(c).

“PINCH YOURSELF” could be taken as a directive to physically “pinch,” or squeeze with one’s finger and thumb,³ one’s own body. “PINCH YOURSELF” could also be taken as expressing that one does not believe that something good that is happening to them is real.⁴ Further, as shown by SPCDG’s specimen, one of SPCDG’s services advertised using the PINCH YOURSELF mark is SPCDG’s lobster buffet. Since lobsters have claws that “pinch,” the mark PINCH YOURSELF also conveys the concept of a “pinching” lobster claw.

Each connotation is one that the public would make fairly readily, and each is readily apparent from the mark itself. *See In re The Place Inc.*, 76 USPQ2d 1467, 1469 (TTAB 2005). Further, at least the first two connotations are not merely descriptive of *any* of SPCDG’s services, and the third connotation is not merely descriptive of at least SPCDG’s hotel, casino, gaming, and entertainment services. *See id.*

Accordingly, PINCH YOURSELF is a double entendre that cannot be refused registration as merely descriptive. *See In re Tea & Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008) (THE FARMACY a double entendre and therefore not merely descriptive); *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products inasmuch as it is suggestive of a nursery rhyme); *No Nonsense Fashions, Inc. v. Consol. Foods Corp.*, 226 USPQ 502, 507 (TTAB 1985) (SHEER ELEGANCE a double entendre not descriptive of pantyhose); *In re Priefert Mfg. Co., Inc.*, 222 USPQ 731, 733 (TTAB 1984) (HAY DOLLY a double entendre due to expression “Hey Dolly” and therefore not merely descriptive of self-loading trailers for hauling hay bales); *In re Del. Punch*

³ *Merriam-Webster’s* online dictionary defines the transitive verb “pinch” as “to squeeze between the finger and thumb or between the jaws of an instrument.” (<http://www.merriam-webster.com/dictionary/pinch>)

⁴ *MacMillan Dictionary* defines the phrase “have to pinch yourself” as “used for saying that you do not believe that something good that is happening to you is real,” providing the example, “I had to pinch myself to make sure I wasn’t dreaming.” (<http://www.macmillandictionary.com/dictionary/british/pinch>)

Co., 186 USPQ 63, 64 (TTAB 1975) (THE SOFT PUNCH a double entendre not descriptive of non-carbonated, non-alcoholic beverages); *In re Nat'l Tea Co.*, 144 USPQ 286 (TTAB 1965) (NO BONES ABOUT IT a double entendre as applied to boneless ham); *In re Happy Baby Carrier Co.*, 179 USPQ 864 (TTAB 1973) (NAPSACK a double entendre as applied to baby carriers); *In re Horsman Dolls Inc.*, 185 USPQ 639 (TTAB 1975) (CRY BABY a double entendre as applied to dolls that “cry real tears”); *In re Grand Metro. Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994) (MUFFUNS a double entendre as applied to muffins); *Henry Siegel Co. v. M & R Int'l Mfg. Co.*, 4 USPQ2d 1154 (TTAB 1987) (CHIC a double entendre and not merely descriptive of women's jeans); *In re Computer Bus. Sys. Group*, 229 USPQ 859 (TTAB 1985) (AUTOMATE a double entendre as applied to computer programs); *Medtronic, Inc. v. Med. Devices, Inc.*, 204 USPQ 317 (TTAB 1979) (NEUROPAC a double entendre as applied to neuropacers); *In re Wilderness Group, Inc.*, 189 USPQ 44 (TTAB 1975) (LET YOUR HIPS SHOULDER THE LOAD a double entendre and not merely descriptive of hiking and camping equipment); *In re Milk Found.*, 170 USPQ 50 (TTAB 1971) (EVERY BODY NEEDS MILK a double entendre for services promoting the dairy industry); *In re Amrise*, 160 USPQ 687 (TTAB 1969) (ITALIAN MAIDE a double entendre as applied to tomato paste and spaghetti sauce); *In re David Crystal, Inc.*, 145 USPQ 95 (TTAB 1965) (SPORTSWEAR FOR EVERYWEAR a double entendre and not merely descriptive of or incapable of distinguishing dresses and suits); *In re Pevely Dairy Co.*, 128 USPQ 13 (TTAB 1960) (SCOOP OF THE MONTH a double entendre as applied to ice cream).

Because PINCH YOURSELF is not merely descriptive as a matter of law, Viejas necessarily has no need to use the mark descriptively in its business. As there is no other

sufficient pleading of damage to be found in Viejas' Opposition, Viejas necessarily has failed to plead standing. Accordingly, Viejas' Opposition should be dismissed. *Cf. Ava Enters. Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659 (TTAB 2008) (granting motion to dismiss where Board determined that as a matter of law a likelihood of confusion could not exist between the opposer's mark and the applicant's mark).

III. Viejas' Opposition Should be Dismissed for Failure to State a Claim

Opposition proceedings are governed by the Federal Rules of Civil Procedure. 37 C.F.R. § 2.116(a). Thus, the Board may grant motions to dismiss an opposition pursuant to Fed. R. Civ. P. 12, and will apply the same standards as would apply in federal court. TBMP § 503.

A motion to dismiss may be based on the lack of a cognizable legal theory or the absence of sufficient factual allegations. *Balistreri v. Pacifica Police Dept.*, 901 F.2d 696, 699 (9th Cir. 1990). Conclusory allegations of law and unwarranted inferences are insufficient to defeat a motion to dismiss. *Cholla Ready Mix, Inc. v. Civish*, 383 F.3d 969, 973 (9th Cir. 2004); *see also Spreewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001) (noting courts are not required to accept as true allegations that are merely conclusory, unwarranted deductions of act, or unreasonable inferences). Further, the Board may take judicial notice of matters of public record in deciding a motion to dismiss. *Olsen v. Idaho State Bd. of Medicine*, 363 F.3d 916, 921-22 (9th Cir. 2004); *accord Biomedical Patent Mgmt. Corp. v. California*, 505 F.3d 1328, 1331 n.1 (Fed. Cir. 2007).

In *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 127 S. Ct. 1955, 1969 (2007), the Supreme Court altered the federal pleading standard, expressly rejecting the "no set of facts" standard from *Conley v. Gibson*. While recognizing that FRCP 8(a)(2) "requires only 'a short

and plain statement of the claim showing that the pleader is entitled to relief,’ in order to ‘give the defendant fair notice of what the . . . claim is and the grounds upon which it rests,’” the Rule “still requires a ‘showing,’ rather than a blanket assertion, of entitlement to relief. Without some factual allegation in the complaint, it is hard to see how a claimant could satisfy the requirement of providing not only ‘fair notice’ of the nature of the claim, but also ‘grounds’ on which the claim rests.” *Twombly*, 550 U.S. at 555, 556 n.3. Thus, while “heightened fact pleading of specifics” is not required, a complaint still must provide “enough facts to state a claim to relief that is plausible on its face.” *Id.* at 570. Finding that the complaint at issue in *Twombly* only contained legal conclusions, rather than any independent allegations sufficient to support the legal claims asserted, the Court found that the *Twombly* plaintiffs failed to “nudge[] their claims across the line from conceivable to plausible,” and accordingly dismissed the complaint.

In *Ashcroft v. Iqbal*, 129 S. Ct. 1937 (2009), the court reaffirmed *Twombly*, holding that although detailed factual allegations are not required, mere conclusory allegations will not suffice. *Iqbal*, 129 S. Ct. at 1949. Thus, in order to survive a motion to dismiss, “a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Id.* (quoting *Twombly*, 550 U.S. at 570). A pleading is facially plausible when it contains “factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* (citing *Twombly* at 556). Although there is no probability requirement, the plausibility standard requires “more than a sheer possibility that a defendant has acted unlawfully,” and “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice.” *Id.* (citing *Twombly* at 556).

Iqbal further clarified that *Twombly* set out a “two-pronged approach” for determining whether a motion to dismiss for failure to state a claim should be granted. *Id.* First, allegations that are mere legal conclusions are identified; such allegations are not entitled to an assumption of truth and cannot be the grounds for finding a plausible claim. *See id.* at 1951. Second, factual allegations are examined to see if they facially suggest plausible entitlement to relief. *Id.*

The Board has recognized the application of *Iqbal* and *Twombly* to inter partes proceedings. *See Doyle v. Al Johnson’s Swedish Rest. & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (finding cancellation petitioner failed to adequately allege standing under *Iqbal* and *Twombly*).

Applying *Iqbal* and *Twombly* to the present Opposition, it is evident that Viejas has failed to state a claim to relief that is plausible on its face. The allegations set forth in paragraphs 4-8 of the Opposition (that the mark is merely descriptive, does not function as a trademark, is not distinctive, and is so highly descriptive as to be incapable of acquiring distinctiveness) are mere legal conclusions not entitled to an assumption of truth and cannot be grounds for finding a plausible claim. *Iqbal*, 129 S. Ct. at 1951. The remaining paragraphs therefore set forth the only factual allegations in the Opposition, namely:

- SPCDG has filed the ‘805 Application and the ‘796 Application for PINCH YOURSELF for the services recited in the Applications (‘805 Opp’n ¶ 1; ‘796 Opp’n ¶ 1);
- Viejas purportedly “provides similar services,” “including restaurant and bar services” (‘805 Opp’n ¶ 2) and “casino gaming and entertainment services” (‘796 Opp’n ¶ 2); and
- Viejas “*has* used the phrase ‘PINCH YOURSELF’ to promote its services” at its restaurants (‘805 Opp’n ¶ 3 (emphasis added)) and at its casino (‘796 Opp’n ¶ 3).

These factual allegations—the only ones found in the Opposition—fail to plausibly suggest any entitlement to relief.

For example, in paragraph 4 of the Opposition Viejas perfunctorily alleges that PINCH YOURSELF is merely descriptive of the services recited in the respective Applications. (‘805 Opp’n ¶ 4; ‘796 Opp’n ¶ 4.) However, for a term to be merely descriptive, it must immediately convey knowledge of a significant quality, characteristic, function, feature, or purpose of the goods or services it identifies with a “degree of particularity.” *In re Gyulay*, 3 USPQ2d at 1009. As discussed above, Viejas does not identify *what* purported significant quality, characteristic, function, feature, or purpose of the services listed in the Applications are immediately conveyed with a degree of particularity by the mark PINCH YOURSELF. (See ‘805 Opp’n ¶ 4; ‘796 Opp’n ¶ 4.) In short, Viejas’s purely legal conclusion that the PINCH YOURSELF mark is merely descriptive contains no factual content that would allow the Board to reasonably infer that the mark is, indeed, merely descriptive. It is the sort of “threadbare recital of the elements of a cause of action” which *Iqbal* refutes.

Viejas’s remaining allegations suffer a similar fate, as each allegation states a different legal conclusion without providing any factual basis for the legal allegations set forth therein. The only factual allegations set forth in the Opposition are that SPCDG filed the present Applications for PINCH YOURSELF; that Viejas provides restaurant, bar, and casino gaming and entertainment services; and that Viejas at some time in the past used PINCH YOURSELF to promote its services. None of these factual allegations plausibly suggest that PINCH YOURSELF “does not function as a trademark” (‘805 Opp’n ¶ 5, ‘796 Opp’n ¶ 5), or “has not become distinctive of Applicant’s services” (‘805 Opp’n ¶ 6, ‘796 Opp’n ¶ 6), or “is so highly

descriptive as to not be capable of acquiring distinctiveness for Applicant's services" ('805 Opp'n ¶ 7, '796 Opp'n ¶ 7).

Thus, like the plaintiff in *Twombly*, Viejas has failed to provide any independent factual allegations to support its legal claims, and has failed to nudge those claims "across the line from conceivable to plausible." Under *Twombly* and *Iqbal*, Viejas's Opposition must be dismissed.

CONCLUSION

For the reasons set forth above, the Opposition must be dismissed.

DATED this 12th day of June, 2012.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

By /Hillary A. Brooks/
Hillary A. Brooks
Registration No. 45,815
Attorney for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing APPLICANT'S MOTION TO DISMISS was served upon Opposer on June 12, 2012 by forwarding said copy via first class mail to Opposer at the following address:

Charles F. Reidelbach, Jr.
Higgs Fletcher & Mack LLP
401 West "A" Street, Suite 2600
San Diego, CA 92101

By: _____


Lisa Riley

MARGER JOHNSON & McCOLLOM, P.C.
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EXHIBIT A

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6 FAX: 619.696.1410

7 Attorneys for Defendants

8
9 **UNITED STATES DISTRICT COURT**
SOUTHERN DISTRICT OF CALIFORNIA

10 SAN PASQUAL CASINO
11 DEVELOPMENT GROUP, INC., an
enterprise fund of the San Pasqual
12 Band of Mission Indians, a Federally-
Recognized Indian Tribe,

13 Plaintiff,

14 v.

15 VIEJAS BAND OF KUMEYAAY
16 INDIANS, a Federally-Recognized
Indian Tribe d/b/a Viejas Casino, et.
17 al.,

18 Defendants.

CASE NO. 11CV1983 JAH POR

**DECLARATION OF ANTHONY R.
PICO IN SUPPORT OF MOTION
TO DISMISS FILED BY
SPECIALLY-APPEARING
DEFENDANTS, VIEJAS BAND OF
KUMEYAAY INDIANS AND ITS
OFFICERS**

CASE FILED: August 29, 2011
DATE: December 12, 2011
TIME: 2:30 p.m.
COURTROOM: 11 (2nd Floor)
JUDGE: Hon. John A. Houston

19
20
21 I, Anthony R. Pico, declare:

22 1. I am the Tribal Chairman for the Viejas Band of Kumeyaay Indians, a
23 federally recognized Indian tribe (the "Viejas Band" or the "Band"). I have served
24 as the chairman from 1983 to 2001, 2003 to 2009, and starting again this year.

25 2. The Viejas Band is a federally recognized Indian tribe which is
26 identified on the Federal Register listing of federally recognized tribes as the
27 Capitan Grande Band of Diegueno Mission Indians of California: Viejas (Baron
28

1 Long) Group of Capitan Grande Band of Mission Indians of the Viejas Reservation,
2 California. A copy of the Federal Register listing is attached as **Exhibit A** to the
3 accompanying Request for Judicial Notice.

4 3. Every enrolled member of the Viejas Band, age 18 or older, is a
5 member of Viejas' "General Council." Every two years, the General Council elects
6 seven of its members to the Tribal Council, including the Chairman. Pursuant to
7 the election and the authority delegated to it by the General Council, the Tribal
8 Council is the governing body of Viejas.

9 4. The Viejas Band owns and operates the Viejas Casino, located
10 approximately 40 minutes east of San Diego, for the benefit of the Band as a whole,
11 to promote the Band's self-determination and general welfare. The Viejas Casino
12 opened in 1991 and is located entirely on the Viejas reservation. The Viejas Casino
13 is a governmental business enterprise of the Viejas Band and is not incorporated or
14 otherwise organized under the laws of any state. Likewise, "Viejas Enterprises" is
15 an arm of the Viejas Band which manages the day to day affairs of the Band's
16 casino and other businesses—it is not a separate entity. The Tribal Council oversees
17 the direction and control of the Viejas Casino and Viejas Enterprises, including
18 authorizing any waivers of sovereign immunity. The managers of the Viejas
19 Casino and Viejas Enterprises are employees of the Viejas Band and answer to the
20 Tribal Council.

21 5. As Tribal Chairman for Viejas, I would be aware of any waivers of the
22 Band's sovereign immunity. The Band has not waived its sovereign immunity
23 relating to the events or parties at issue in this case.

24 I declare under penalty of perjury under the laws of the United States of
25 America that the foregoing is true and correct. Dated this 4th day of November,
26 2011, in Alpine, California.

27
28 
Anthony R. Pico

EXHIBIT B

NEAL M. COHEN (184978) [nmc@viplawgroup.com]
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Attorneys for Plaintiff

SAN PASQUAL CASINO DEVELOPMENT GROUP INC., an enterprise
 fund of the San Pasqual Band of Mission Indians, a
 Federally-Recognized Indian Tribe

**UNITED STATES DISTRICT COURT
 SOUTHERN DISTRICT OF CALIFORNIA**

SAN PASQUAL CASINO DEVELOPMENT
 GROUP INC., an enterprise fund of
 the San Pasqual Band of Mission
 Indians, a Federally-Recognized
 Indian Tribe,

Plaintiff,

vs.

VIEJAS BAND OF KUMEYAAAY INDIANS,
 a Federally-Recognized Indian
 Tribe d/b/a Viejas Casino

Defendant.

Case No. **'11CV1983 JAH POR**

**COMPLAINT FOR TRADEMARK
 INFRINGEMENT, COPYRIGHT
 INFRINGEMENT, AND UNFAIR
 COMPETITION**

DEMAND FOR JURY TRIAL

Plaintiff SAN PASQUAL CASINO DEVELOPMENT GROUP INC.
 ("SPCDG") alleges as follows against Defendant VIEJAS BAND OF
 KUMEYAAAY INDIANS d/b/a Viejas Casino ("Viejas"), on personal
 knowledge as to Plaintiff's own activities and on information
 and belief as to the activities of others, as follows:

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NATURE OF THE CASE

1. This is an action for common law trademark infringement; common law trade dress infringement; unfair competition under the laws of the United States (codified at 15 U.S.C. § 1117, *et seq.*); unfair competition under California's Unfair Competition Law, Cal. Bus. & Prof. Code § 17200; common law unfair competition; and copyright infringement under the Copyright Act of 1976, as amended (codified at 17 U.S.C. § 101 *et seq.*).

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JURISDICTION AND VENUE

2. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a), and 1362.

3. This Court has supplemental jurisdiction over Plaintiff's state law claims pursuant to the provisions of 28 U.S.C. § 1338(b) insofar as the claims are joined with a substantial and related federal claim arising under the trademark laws of the United States. See 15 U.S.C. § 1051 *et seq.*

4. This Court has personal jurisdiction over Defendant at least because Defendant has substantial contacts in the State of California related to the claims in this action and Defendant

1 engaged in the wrongful acts alleged herein in the State of
2 California.

3 5. Venue is proper in this judicial district pursuant to
4 28 U.S.C. §§ 1391(b)(2) and 1400(a).

5
6 **PARTIES**

7 6. Plaintiff is a wholly-owned, tribally chartered
8 corporation formed under the laws of the San Pasqual Band of
9 Mission Indians, a federally recognized Indian tribe.
10 Plaintiff's headquarters and principal business address are at
11 16300 Nyemii Pass Road, Valley Center, California 92082.

12 7. Defendant is a federally recognized Indian tribe with
13 its headquarters and principal business address at 5000 Willows
14 Road, Alpine, California 91901.

15 8. Plaintiff and Defendant each operate competing casinos
16 in the San Diego area. Plaintiff is responsible for the
17 operation, management and development of Valley View Casino &
18 Hotel ("Valley View"), which is located approximately one hour
19 north of San Diego at 16300 Nyemii Pass Road, Valley Center,
20 California 92082. Defendant's casino, Viejas Casino, is located
21 approximately forty minutes east of San Diego, at 5000 Willows
22 Road, Alpine, California 91901. Both Valley View and Viejas
23 Casino are listed as San Diego-area casinos on the City of San
24 Diego's website, www.sandiego.com, along with Barona Casino,
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1 Harrah's Rincon Casino and Resort, Pala Casino Spa & Resort,
2 Pechanga Resort & Casino, and Sycuan Casino.

3 **STATEMENT OF FACTS COMMON TO ALL COUNTS**

4 **Plaintiff's Intellectual Property**

5 9. Valley View opened on April 18, 2001, marking a
6 milestone in the history of Plaintiff's tribe. Plaintiff was
7 formed on November 20, 2004 and thereafter assumed exclusive
8 responsibility for the operation, management and development of
9 Valley View. In the ten years since Valley View opened,
10 Plaintiff and its Tribe have invested significant capital and
11 time to make Valley View the premier gaming destination it is
12 today. As part of these efforts, Plaintiff has created, sought
13 and obtained protection for, and enforced an impressive
14 intellectual property portfolio, which includes trademarks,
15 service marks, trade dress, and copyrights.

16 10. To succeed in the crowded San Diego-area market,
17 Plaintiff has undertaken several steps to set itself apart from
18 its competitors. One such effort is Plaintiff's all-you-can-eat
19 lobster buffet, marketed under the mark PINCH YOURSELF since at
20 least September 2009. Since the campaign began, Plaintiff has
21 used and displayed the PINCH YOURSELF mark in the sale and
22 advertising of its services, which include bar and restaurant
23 services, gaming and casino services, and customer loyalty and
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1 customer club services. Plaintiff prominently featured its
2 PINCH YOURSELF mark in a wide variety of advertisements,
3 including: on postcards; on the NBC San Diego website; in
4 various issues of the *San Diego Reader*, *Casino Player* magazine,
5 *Riviera* magazine, and *Inland Empire* magazine; in multiple issues
6 of Plaintiff's *Valley View Casino Newsletter*; on multiple local
7 billboards; and on T-shirts. As a result of Plaintiff's use of
8 its PINCH YOURSELF mark, Plaintiff's all-you-can-eat lobster
9 buffet has been a resounding success, and consumers have come to
10 recognize PINCH YOURSELF as an indicator of Plaintiff's goods
11 and services. Plaintiff's PINCH YOURSELF mark is often
12 displayed with a claw "pinching" the mark.
13

14 11. In another step to set itself apart from the
15 competition, Plaintiff created in house a pair of television
16 commercials advertising and promoting Valley View: "Hotel
17 Branding," subtitled "L'Amore Valley View Casino #1"
18 (hereinafter "L'Amore #1 Commercial"); and "VIEW0411," subtitled
19 "L'Amore Valley View Casino #2" (hereinafter "L'Amore #2
20 Commercial") (collectively, "the L'Amore Commercials").
21

22 12. Both L'Amore Commercials feature a distinctive
23 combination of elements that serve to identify and distinguish
24 Plaintiff's goods and services from those of others and to
25 indicate the source of Plaintiff's goods and services, namely:
26

- a. The use of a catchy piece of music with a driving beat;
- b. The complete absence of spoken narration;
- c. The use of multiple short vignettes that rapidly change while simultaneously giving the impression of a slow, sweeping panoramic view;
- d. The use of white, sans-serif font text moving across the images of the vignettes; and
- e. The use of emphasis on particular words that, in conjunction with the underlying images, evoke particular moods and create the sense that Plaintiff's casino is sophisticated, indulgent, luxurious, opulent, and sexy, yet refined (collectively, "the L'Amore Trade Dress").

13. Both L'Amore Commercials feature a unique selection and arrangement of expressive elements, namely:

- a. Artistic choices as to the shooting and editing of multiple short vignettes that rapidly change while simultaneously giving the impression of a slow, sweeping panoramic view, the vignettes portraying different aspects of Plaintiff's casino including slot machines, table games, fine dining, gourmet food, and hotel services;

1 b. Artistic choices as to camera angles, particularly as
2 to mixing wide-angled, slowly-sweeping shots with
3 tightly focused, close-up shots;

4 c. Artistic choices as to lighting, particularly as to
5 using low light in certain vignettes to create a
6 moody, opulent ambience;

7
8 d. Selection and arrangement of words in white, san-serif
9 font that scroll across the vignettes, particular
10 words emphasized to create the sense that Plaintiff's
11 casino is sophisticated, indulgent, luxurious,
12 opulent, and sexy, yet refined;

13 i. With respect to the L'Amore #1 Commercial,
14 emphasis on the word "insatiable" in conjunction
15 with an image of fine food, conveying the feeling
16 that Plaintiff's casino offers rich, decadent
17 dining experiences;

18
19 ii. With respect to the L'Amore #1 Commercial,
20 emphasis on the word "exciting" in conjunction
21 with an image of a table game, conveying the
22 feeling that Plaintiff's casino offers fun and
23 excitement to its patrons;

24
25 e. Artistic choices as to the audio component of the
26 commercials, namely

- i. A complete absence of spoken narration;
 - ii. The use of scrolling text across the vignettes in the place of spoken narration; and
 - iii. The use of a catchy piece of music with a driving beat;
- f. Artistic choices as to pacing such that a sense of excitement is created, with
 - i. 17 different vignettes shown over the course of the L'Amore #1 Commercial's thirty seconds, each vignette lasting on average 1.76 seconds; and
 - ii. 18 different vignettes shown over the course of the L'Amore #2 Commercial's thirty seconds, each vignette lasting on average 1.72 seconds;
- g. Artistic choices as to the characters portrayed, with couples shown in addition to groups of people and with no particular person, couple, or group of people developed;
 - i. With respect to the L'Amore #1 commercial, artistic choices as to the portrayal of winning characters, with only female characters clearly shown winning the casino's games; and
- h. Artistic choices as to the sequence of the vignettes, namely, a seemingly random intermixing of the

1 different vignettes without any clear, natural
2 progression in storyline (collectively, "the L'Amore
3 Expressive Elements").

4 14. Plaintiff's L'Amore #1 Commercial first aired in San
5 Diego, Orange, Los Angeles, Riverside, Ventura, Santa Barbara,
6 and San Bernandino Counties (collectively, "the Southern
7 California Market") on February 7, 2011. Plaintiff's L'Amore #2
8 Commercial first aired in the Southern California Market on
9 April 11, 2011. Since their first airings, both commercials
10 have run thousands of times. As of the filing of this
11 Complaint, both commercials are still airing in the Southern
12 California Market. Additionally, both L'Amore Commercials have
13 been posted on Plaintiff's YouTube Channel, "VVCasinoHotel,"
14 since late April 2011.

15 15. Plaintiff's efforts to set itself apart, including
16 through the use of its PINCH YOURSELF mark and its L'Amore
17 Commercials, have paid off: In its "2011 Best of Gaming" issue,
18 *Casino Player* Magazine recognized Plaintiff as the Best Overall
19 Gaming Resort in California, and awarded Plaintiff its sixth
20 consecutive Best Buffet title for Plaintiff's all-you-can-eat
21 lobster buffet.

22 16. On August 10, 2011, Plaintiff applied for federal
23 trademark registration of its PINCH YOURSELF mark: (a) Ser. No.

1 85/394,831 for customer loyalty services and customer club
2 services, for commercial, promotional and/or advertising
3 purposes, first used in commerce in connection with the
4 identified services at least as early as December 2010; (b) Ser.
5 No. 85/394,805 for restaurant; hotel, bar and restaurant
6 services; hotel accommodation services; hotel services for
7 preferred customers; hotel, restaurant and catering services;
8 bar and restaurant services; cafe and restaurant services; and
9 restaurant services, first used in commerce in connection with
10 the identified services at least as early as September 2009; and
11 (c) Ser. No. 85/394,796 for entertainment services, namely,
12 casino gaming; gaming services in the nature of casino gaming;
13 casino services; and entertainment services, namely, live
14 appearances by a professional entertainer, first used in
15 commerce in connection with the identified services at least as
16 early as September 2009. As of the filing of this Complaint,
17 Plaintiff's trademark applications remain pending.
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20 17. Also on August 10, 2011, Plaintiff sent the following
21 applications for copyright registration, along with a deposit
22 and fee, to the United States Copyright Office: (a) Case # 1-
23 646798370 for the L'Amore #1 commercial, and (b) Case #1-
24 646798471 for the L'Amore #2 commercial. Plaintiff's
25 applications were both received by the Copyright Office on or
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1 about August 10, 2011. As of the filing of this Complaint,
2 Plaintiff's copyright applications remain pending.

3 **Defendant's Infringement and Misappropriation of Plaintiff's**
4 **Intellectual Property**

5 18. By letter dated February 17, 2011, Plaintiff
6 contacted Defendant regarding unauthorized use of one of
7 Plaintiff's registered trademarks by Defendant. By email dated
8 March 1, 2011, Defendant's then General Manager indicated that
9 Defendant would cease use of the mark.

10 19. On or about August 3, 2011, Defendant launched an
11 advertising campaign whereby Defendant marketed an all-you-can-
12 eat snow crab buffet under the mark PINCH YOURSELF. Defendant
13 announced its campaign via press releases posted on several
14 national websites, including www.reuters.com, www.cnbc.com,
15 www.businesswire.com, finance.yahoo.com, and
16 www.allbusiness.com, as well as through several postings on
17 Defendant's page on www.facebook.com and Defendant's own
18 website, www.viejas.com. Defendant also created a commercial
19 for its campaign that prominently features the PINCH YOURSELF
20 mark, which was posted on at least Defendant's www.facebook.com
21 page. In several instances, Defendant uses PINCH YOURSELF with
22 an image of a claw "pinching" the mark.
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25 20. Sometime around July 16, 2011, Defendant first aired a
26 television commercial, with the opening verbiage "Are you ready
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1 to play?", advertising and promoting its casino (hereinafter
2 "the Viejas Commercial").

3 21. The Viejas Commercial features the same or a similar
4 combination of elements as the L'Amore Trade Dress, namely:

5 a. The use of a catchy piece of music with a driving
6 beat;

7 b. A complete absence of spoken narration;

8 c. The use of multiple short vignettes that rapidly
9 change while simultaneously giving the impression of a
10 slow, sweeping panoramic view;

11 d. The use of white, sans-serif font text moving across
12 the images of the vignettes; and

13 e. The use of emphasis on particular words that, in
14 conjunction with the underlying images, evokes
15 particular moods and creates the sense that
16 Defendant's casino is sophisticated, indulgent,
17 luxurious, opulent, and sexy.

18 22. The Viejas Commercial also features a substantially
19 similar selection and arrangement of expressive elements as
20 those seen in the L'Amore Commercials, namely:

21 a. Artistic choices as to the shooting and editing of
22 multiple short vignettes that rapidly change while
23 simultaneously giving the impression of a slow,
24

1 sweeping panoramic view, the vignettes portraying
2 different aspects of Defendant's casino including slot
3 machines, table games, fine dining, and gourmet food,
4 the vignettes further giving the impression that
5 Defendant offers hotel services through the use of two
6 ambiguous scenes showing a card that could be mistaken
7 for a hotel room key card even though Defendant does
8 not offer hotel services;
9

10 b. Artistic choices as to camera angles, particularly as
11 to mixing wide-angled, slowly-sweeping shots with
12 tightly focused, close-up shots;
13

14 c. Artistic choices as to lighting, particularly as to
15 using low light in certain vignettes to create a
16 moody, opulent ambience;
17

18 d. Selection and arrangement of words in white, san-serif
19 font that scroll across the vignettes, particular
20 words emphasized to create the sense that Defendant's
21 casino is sophisticated, indulgent, luxurious,
22 opulent, and sexy;
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24 i. In substantial similarity to the L'Amore #1
25 Commercial, emphasis on the word "indulge" in
26 conjunction with an image of fine food, conveying
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1 the feeling that Defendant's casino offers rich,
2 decadent dining experiences;

3 ii. In substantial similarity to the L'Amore #1
4 Commercial, emphasis on the word "excitement" in
5 conjunction with an image of a table game,
6 conveying the feeling that Defendant's casino
7 offers fun and excitement to its patrons;
8

9 e. Artistic choices as to the audio component of the
10 Viejas Commercial, namely

11 i. A complete absence of spoken narration;
12 ii. The use of scrolling text across the vignettes in
13 the place of spoken narration; and
14 iii. The use of a catchy piece of music with a driving
15 beat;
16

17 f. Artistic choices as to pacing such that a sense of
18 excitement is created, with 19 different vignettes
19 shown over the course of the Viejas Commercial's
20 thirty seconds, each vignette lasting on average 1.67
21 seconds;
22

23 g. Artistic choices as to the characters portrayed, with
24 couples shown in addition to groups of people, with no
25 particular person, couple, or group of people
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1 developed, and with only female characters clearly
2 shown winning the casino's games; and

3 h. Artistic choices as to the sequence of the vignettes,
4 namely, a seemingly random intermixing of the
5 different vignettes without any clear natural
6 progression in storyline.
7

8 23. Defendant's Viejas Commercial aired approximately five
9 months after the L'Amore #1 Commercial first aired, and
10 approximately three months after the L'Amore #2 Commercial first
11 aired. The Viejas Commercial has aired in at least the Southern
12 California Market.

13 24. Between August 10, 2011, and August 17, 2011,
14 Plaintiff sent letters to Defendant regarding Defendant's
15 infringement and misappropriation of the PINCH YOURSELF mark and
16 the L'Amore Commercials and requesting that Defendant cease its
17 PINCH YOURSELF campaign and pull the Viejas Commercial.
18 Defendant refused to do so.
19

20 25. Because of Defendant's apparent concerted effort to
21 continue a pattern of copying and infringing Plaintiff's
22 intellectual property for the purpose of trading off Plaintiff's
23 goodwill, this Complaint necessarily follows.
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COUNT 1**Common Law Trademark Infringement of the PINCH YOURSELF Mark**

26. Plaintiff repeats and realleges each of the allegations contained in paragraphs 1 through 25 of this Complaint as if fully set forth herein.

27. Plaintiff has continuously used the PINCH YOURSELF mark in commerce in connection with Plaintiff's services, including in connection with Plaintiff's all-you-can-eat lobster buffet, since at least as early as September 2009 and, accordingly, has established common law trademark rights in the PINCH YOURSELF mark.

28. Defendant's unauthorized use in commerce of the PINCH YOURSELF mark in association with Defendant's all-you-can-eat snow crab buffet constitutes infringement of Plaintiff's common law trademark rights, misappropriates the valuable goodwill developed by Plaintiff in the PINCH YOURSELF mark, and is likely to cause confusion among the relevant consuming public.

29. Defendant was, or should have been, aware of Plaintiff's use of and corresponding rights in the PINCH YOURSELF mark. Defendant's acts aforesaid, including using names, terms, and/or marks that are identical or, at least, confusingly similar to Plaintiff's PINCH YOURSELF mark for identical or substantially similar goods and services,

1 constitute willful infringement of Plaintiff's rights in the
2 PINCH YOURSELF mark.

3 30. Defendant's acts of willful infringement of
4 Plaintiff's rights in the PINCH YOURSELF mark have caused and,
5 unless restrained, will continue to cause great and irreparable
6 injury to Plaintiff, Plaintiff's business, and to the goodwill
7 and reputation of Plaintiff in an amount that cannot be
8 ascertained at this time, leaving Plaintiff no adequate remedy
9 at law.

10
11 31. Defendant's acts are the proximate cause of such
12 injury and damage.

13 32. By reason of the foregoing, Plaintiff is entitled to
14 preliminary and permanent injunctive relief against Defendant,
15 and anyone acting in concert with Defendant, to restrain further
16 acts of infringement of Plaintiff's rights and, after trial, to
17 recover any damages proven to have been caused by reason of
18 Defendant's aforesaid acts of infringement and any enhanced
19 damages justified by the willful and intentional nature of such
20 acts.
21
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COUNT TWO**Federal Unfair Competition with Respect to the PINCH YOURSELF
Mark
(15 U.S.C. § 1125)**

33. Plaintiff repeats and realleges each of the allegations contained in paragraphs 1 through 32 of this Complaint as if fully set forth herein.

34. By its knowing and intentional unauthorized imitation, adoption, and use of Plaintiff's PINCH YOURSELF mark and/or marks which are confusingly similar to Plaintiff's PINCH YOURSELF mark in association with Defendant's goods and services, Defendant has and continues to falsely designate its goods and services as being derived or affiliated with those of the Plaintiff.

35. Defendant's use of the PINCH YOURSELF mark is likely to cause and/or has caused relevant consumers to mistakenly believe that Defendant has an affiliation with Plaintiff, that Defendant's business is sponsored or approved by Plaintiff, or that Defendant is otherwise associated with or has obtained permission from Plaintiff to use the PINCH YOURSELF mark in connection with the sale of Defendant's goods and services.

36. By engaging in the unauthorized activities described above, Defendant has made, and continues to make, false, deceptive, and misleading statements constituting false representations and false advertising made in connection with

1 the sale of goods or services distributed in interstate commerce
2 in violation of Section 43(a) of the Lanham Act, 15 U.S.C. §
3 1125(a). Furthermore, in view of the notices provided to
4 Defendant by the acts of Plaintiff, such activities were, and
5 remain, willful and intentional.
6

7 37. Defendant's willful and intentional acts of unfair
8 competition, false advertising, and false designation of origin,
9 have caused and are causing great and irreparable injury and
10 damage to Plaintiff's business and its goodwill and reputation
11 in an amount that cannot be ascertained at this time and, unless
12 preliminarily and permanently restrained, will cause further
13 irreparable injury and damage, leaving Plaintiff with no
14 adequate remedy at law.
15

16 38. By reason of the foregoing, Plaintiff is entitled to
17 injunctive relief against Defendant, and anyone acting in
18 concert with Defendant, to restrain further acts of unfair
19 competition, false advertising, and false designation of origin
20 and, after trial, to recover any damages proven to have been
21 caused by reason of Defendant's aforesaid acts, and to recover
22 enhanced damages based on Defendant's willful, intentional,
23 and/or grossly negligent acts.
24
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COUNT THREE**Statutory Unfair Competition with Respect to the PINCH YOURSELF
Mark
(Cal. Bus. & Prof. Code § 17200)**

39. Plaintiff repeats and realleges each of the allegations contained in paragraphs 1 through 38 of this Complaint as if fully set forth herein.

40. Through its unauthorized use of the PINCH YOURSELF mark, as well as by continuing to engage in a willful and concerted effort to trade on Plaintiff's goodwill copying and/or imitating Plaintiff's PINCH YOURSELF mark, Defendant has engaged in unlawful and unfair business acts or practices in violation of Cal. Bus. & Prof. Code § 17200.

41. Defendant was, or should have been, aware of Plaintiff's use of and corresponding rights in the PINCH YOURSELF mark. Defendant's acts aforesaid constitute willful and intentional violation of Cal. Bus. & Prof. Code § 17200.

42. Defendant's willful and intentional violation of Cal. Bus. & Prof. Code § 17200 has caused and is causing great and irreparable injury and damage to Plaintiff's business and its goodwill and reputation in an amount that cannot be ascertained at this time and, unless preliminarily and permanently restrained, will cause further irreparable injury and damage, leaving Plaintiff with no adequate remedy at law.

1 43. Defendant's acts are the proximate cause of such
2 injury and damage.

3 44. By reason of the foregoing, Plaintiff is entitled to
4 injunctive relief against Defendant, and anyone acting in
5 concert with Defendant, to restrain further violation of Cal.
6 Bus. & Prof. Code § 17200.
7

8 **COUNT FOUR**

9 **Common Law Infringement of the L'Amore Trade Dress**

10 45. Plaintiff repeats and realleges each of the
11 allegations contained in paragraphs 1 through 44 of this
12 Complaint as if fully set forth herein.

13 46. Plaintiff's L'Amore Trade Dress is non-functional and
14 is inherently distinctive or has acquired secondary meaning
15 through its extensive, exclusive use by Plaintiff and its
16 association by purchasers with Plaintiff's goods and services.
17

18 47. Plaintiff has continuously used the L'Amore Trade
19 Dress in commerce in connection with Plaintiff's goods and
20 services since at least as early as February 7, 2011, and,
21 accordingly, has established common law trade dress rights in
22 the L'Amore Trade Dress.
23

24 48. Defendant's unauthorized use in commerce of the
25 L'Amore Trade Dress via Defendant's Viejas commercial
26 constitutes infringement of Plaintiff's common law trade dress
27
28

1 rights, misappropriates the valuable goodwill developed by
2 Plaintiff in the L'Amore Trade Dress, and is likely to cause
3 confusion among the relevant consuming public.

4 49. Defendant was, or should have been, aware of
5 Plaintiff's use of and corresponding rights in the L'Amore Trade
6 Dress. Defendant's acts aforesaid, including incorporating
7 trade dress in its Viejas commercial that is identical or, at
8 least, confusingly similar to Plaintiff's L'Amore Trade Dress
9 for identical or substantially similar goods and services,
10 constitutes willful infringement of Plaintiff's rights in the
11 L'Amore Trade Dress.
12

13 50. Defendant's acts of willful infringement of
14 Plaintiff's rights in the L'Amore Trade Dress have caused and,
15 unless restrained, will continue to cause great and irreparable
16 injury to Plaintiff, Plaintiff's business, and to the goodwill
17 and reputation of Plaintiff in an amount that cannot be
18 ascertained at this time, leaving Plaintiff no adequate remedy
19 at law.
20

21 51. Defendant's acts are the proximate cause of such
22 injury and damage.
23

24 52. By reason of the foregoing, Plaintiff is entitled to
25 preliminary and permanent injunctive relief against Defendant,
26 and anyone acting in concert with Defendant, to restrain further
27
28

1 acts of infringement of Plaintiff's rights and, after trial, to
2 recover any damages proven to have been caused by reason of
3 Defendant's aforesaid acts of infringement and any enhanced
4 damages justified by the willful and intentional nature of such
5 acts.
6

7 **COUNT FIVE**

8 **Federal Unfair Competition with Respect to the L'Amore Trade**
9 **Dress**
10 **(15 U.S.C. § 1125)**

11 53. Plaintiff repeats and realleges each of the
12 allegations contained in paragraphs 1 through 52 of this
13 Complaint as if fully set forth herein.

14 54. By its knowing and intentional unauthorized imitation,
15 adoption, and use of Plaintiff's L'Amore Trade Dress and/or
16 trade dress which is confusingly similar to Plaintiff's L'Amore
17 Trade Dress in association with Defendant's goods and services
18 through its Viejas Commercial, Defendant has and continues to
19 falsely designate its goods and services as being derived or
20 affiliated with those of the Plaintiff.

21 55. Defendant's use of the L'Amore Trade Dress is likely
22 to cause relevant consumers to mistakenly believe that Defendant
23 has an affiliation with Plaintiff, that Defendant's business is
24 sponsored or approved by Plaintiff, or that Defendant is
25 otherwise associated with or has obtained permission from
26

1 Plaintiff to use the L'Amore Trade Dress in connection with the
2 sale of Defendant's goods and services.

3 56. By engaging in the unauthorized activities described
4 above, Defendant has made, and continues to make, false,
5 deceptive, and misleading statements constituting false
6 representations and false advertising made in connection with
7 the sale of goods or services distributed in interstate commerce
8 in violation of Section 43(a) of the Lanham Act, 15 U.S.C. §
9 1125(a). Furthermore, in view of the notices provided to
10 Defendant by the acts of Plaintiff, such activities were, and
11 remain, willful and intentional.
12

13 57. Defendant's willful and intentional acts of unfair
14 competition, false advertising, and false designation of origin,
15 have caused and are causing great and irreparable injury and
16 damage to Plaintiff's business and its goodwill and reputation
17 in an amount that cannot be ascertained at this time and, unless
18 preliminarily and permanently restrained, will cause further
19 irreparable injury and damage, leaving Plaintiff with no
20 adequate remedy at law.
21

22 58. Defendant's acts are the proximate cause of such
23 injury and damage.
24

25 59. By reason of the foregoing, Plaintiff is entitled to
26 injunctive relief against Defendant, and anyone acting in
27

1 concert with Defendant, to restrain further acts of unfair
2 competition, false advertising, and false designation of origin
3 and, after trial, to recover any damages proven to have been
4 caused by reason of Defendant's aforesaid acts, and to recover
5 enhanced damages based on Defendant's willful, intentional,
6 and/or grossly negligent acts.
7

8 **COUNT SIX**

9 **Unfair Competition with Respect to the L'Amore Trade Dress**
10 **(Cal. Bus. & Prof. Code § 17200)**

11 60. Plaintiff repeats and realleges each of the
12 allegations contained in paragraphs 1 through 59 of this
13 Complaint as if fully set forth herein.

14 61. Through its unauthorized use of the L'Amore Trade
15 Dress, as well as by continuing to engage in a willful and
16 concerted effort to trade on Plaintiff's goodwill by copying
17 and/or imitating Plaintiff's L'Amore Trade Dress, Defendant has
18 engaged in unlawful and unfair business acts or practices in
19 violation of Cal. Bus. & Prof. Code § 17200.
20

21 62. Defendant's willful and intentional violation of Cal.
22 Bus. & Prof. Code § 17200 has caused and is causing great and
23 irreparable injury and damage to Plaintiff's business and its
24 goodwill and reputation in an amount that cannot be ascertained
25 at this time and, unless preliminarily and permanently
26
27
28

1 restrained, will cause further irreparable injury and damage,
2 leaving Plaintiff with no adequate remedy at law.

3 63. Defendant's acts are the proximate cause of such
4 injury and damage.

5 64. By reason of the foregoing, Plaintiff is entitled to
6 injunctive relief against Defendant, and anyone acting in
7 concert with Defendant, to restrain further violation of Cal.
8 Bus. & Prof. Code § 17200.

10 **COUNT SEVEN**

11 **Copyright Infringement of the L'Amore #1 Commercial**

12 65. Plaintiff repeats and realleges each of the
13 allegations contained in paragraphs 1 through 64 of this
14 Complaint as if fully set forth herein.

15 66. Plaintiff's L'Amore #1 Commercial is an original,
16 independently created, and creative work and is copyrightable
17 under United States law.

18 67. Plaintiff is the sole owner of the copyright in the
19 L'Amore #1 Commercial and has applied and paid the fee for
20 registration of the L'Amore #1 Commercial with the United States
21 Copyright Office.

22 68. Plaintiff's L'Amore #1 Commercial was widely
23 disseminated prior to Defendant's creation of the Viejas
24
25
26
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28

1 Commercial such that Defendant had access to the L'Amore #1
2 Commercial at the time it created the Viejas Commercial.

3 69. Defendant's Viejas Commercial contains specific
4 similarities to the L'Amore Expressive Elements of Plaintiff's
5 L'Amore #1 Commercial including similarities in plot, themes,
6 dialogue, mood, setting, pace, characters, and sequence of
7 events; has substantially the same total concept and feel as the
8 L'Amore #1 Commercial; and is accordingly substantially similar
9 to the L'Amore #1 Commercial.
10

11 70. Because of Defendant's access to the L'Amore #1
12 Commercial and because of the substantial similarity between
13 Defendant's Viejas Commercial and the L'Amore #1 Commercial,
14 Defendant must have and did copy the L'Amore #1 Commercial and
15 therefore has infringed and continues to infringe Plaintiff's
16 copyright in the L'Amore #1 Commercial.
17

18 71. Defendant was, or should have been, aware of
19 Plaintiff's copyright in the L'Amore #1 Commercial. Defendant's
20 acts aforesaid, including its unauthorized copying of the
21 L'Amore #1 Commercial through its creation of the Viejas
22 Commercial, constitutes willful infringement of Plaintiff's
23 copyright in the L'Amore #1 Commercial.
24

25 72. Defendant's willful and intentional acts of
26 infringement have caused and are causing great and irreparable
27

1 injury and damage to Plaintiff's business in an amount that
2 cannot be ascertained at this time and, unless preliminarily and
3 permanently restrained, will cause further irreparable injury
4 and damage, leaving Plaintiff with no adequate remedy at law.

5 73. Defendant's acts are the proximate cause of such
6 injury and damage.
7

8 74. By reason of the foregoing, Plaintiff is entitled to
9 injunctive relief against Defendant, and anyone acting in
10 concert with Defendant, to restrain further acts of infringement
11 and, after trial, to recover any damages proven to have been
12 caused by reason of Defendant's aforesaid acts, and to recover
13 enhanced damages based on Defendant's willful, intentional,
14 and/or grossly negligent acts.
15

16 **COUNT EIGHT**

17 **Copyright Infringement of the L'Amore #2 Commercial**

18 75. Plaintiff repeats and realleges each of the
19 allegations contained in paragraphs 1 through 74 of this
20 Complaint as if fully set forth herein.

21 76. Plaintiff's L'Amore #2 Commercial is an original,
22 independently created, and creative work and is copyrightable
23 under United States law.
24

25 77. Plaintiff is the sole owner of the copyright in the
26 L'Amore #2 Commercial and has applied for and paid the fee for
27

1 registration of the L'Amore #2 Commercial with the United States
2 Copyright Office.

3 78. Plaintiff's L'Amore #2 Commercial was widely
4 disseminated prior to Defendant's creation of the Viejas
5 Commercial such that Defendant had access to the L'Amore #2
6 Commercial at the time it created the Viejas Commercial.
7

8 79. Defendant's Viejas Commercial contains specific
9 similarities to the L'Amore Expressive Elements of Plaintiff's
10 L'Amore #2 Commercial including similarities in plot, themes,
11 dialogue, mood, setting, pace, characters, and sequence of
12 events; has substantially the same total concept and feel as the
13 L'Amore #2 Commercial; and is accordingly substantially similar
14 to the L'Amore #2 Commercial.
15

16 80. Because of Defendant's access to the L'Amore #2
17 Commercial and because of the substantial similarity between
18 Defendant's Viejas Commercial and the L'Amore #2 Commercial,
19 Defendant must have and did copy the L'Amore #2 Commercial and
20 therefore has infringed and continues to infringe Plaintiff's
21 copyright in the L'Amore #2 Commercial.
22

23 81. Defendant was, or should have been, aware of
24 Plaintiff's copyright in the L'Amore #2 Commercial. Defendant's
25 acts aforesaid, including its unauthorized copying of the
26
27
28

1 L'Amore #2 Commercial, constitutes willful infringement of
2 Plaintiff's copyright in the L'Amore #2 Commercial.

3 82. Defendant's willful and intentional acts of
4 infringement have caused and are causing great and irreparable
5 injury and damage to Plaintiff's business in an amount that
6 cannot be ascertained at this time and, unless preliminarily and
7 permanently restrained, will cause further irreparable injury
8 and damage, leaving Plaintiff with no adequate remedy at law.

9
10 83. Defendant's acts are the proximate cause of such
11 injury and damage.

12 84. By reason of the foregoing, Plaintiff is entitled to
13 injunctive relief against Defendant, and anyone acting in
14 concert with Defendant, to restrain further acts of infringement
15 and, after trial, to recover any damages proven to have been
16 caused by reason of Defendant's aforesaid acts, and to recover
17 enhanced damages based on Defendant's willful, intentional,
18 and/or grossly negligent acts.

19
20 **RELIEF REQUESTED**

21 WHEREFORE, Plaintiff SPCDG respectfully prays for the
22 following relief:

23
24 A. A preliminary and permanent nationwide injunction
25 enjoining Defendant, its employees, agents, officers, directors,
26 attorneys, representatives, successors, affiliates, subsidiaries

1 E. An award of damages to compensate for Defendant's
2 unfair competition in an amount to be proven at trial, including
3 Plaintiff's actual damages and Defendant's profits attributable
4 to the unfair competition;

5 F. An order awarding Plaintiff punitive damages on
6 account of Defendant's willful violations of law;

7 G. An order awarding Plaintiff prejudgment and post
8 judgment interest;

9 H. An order for corrective advertising in a form, manner,
10 and frequency that is acceptable to Plaintiff and the Court; and

11 I. All other relief, in law or in equity, to which
12 Plaintiff may be entitled, or which the Court deems just and
13 proper.
14

15
16 Respectfully,

17 Vista IP Law Group LLP

18 August 29, 2011

19 by: s/Neal M. Cohen

20 Attorneys for Plaintiff

21 SAN PASQUAL CASINO DEVELOPMENT
22 GROUP INC., an enterprise fund of
23 the San Pasqual Band of Mission
24 Indians, a Federally-Recognized
25 Indian Tribe
26
27
28

JURY DEMAND

Pursuant to F.R.Civ.P. Rule 38(b), and L.R. 38.1, Plaintiff
demands a jury trial on all issues triable to a jury.

Respectfully,

Vista IP Law Group LLP

August 29, 2011

by: s/Neal M. Cohen

Attorneys for Plaintiff

SAN PASQUAL CASINO DEVELOPMENT
GROUP INC., an enterprise fund of
the San Pasqual Band of Mission
Indians, a Federally-Recognized
Indian Tribe

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

SAN PASQUAL CASINO DEVELOPMENT GROUP INC., an enterprise fund of the San Pasqual Band of Mission Indians...

(b) County of Residence of First Listed Plaintiff San Diego, CA

(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number)

Neal M. Cohen 949.724.1849

Vista IP Law Group LLP, 2040 Main St., #710 Irvine, CA 92614

DEFENDANTS

VIEJAS BAND OF KUMEYAAY INDIANS, a Federally-Recognized Indian Tribe d/b/a Viejas Casino

County of Residence of First Listed Defendant

(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.

'11CV1983 JAH POR

Attorneys (If Known)

II. BASIS OF JURISDICTION

(Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
- ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant
- ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES

(For Diversity Cases Only)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT

(Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury PERSONAL INJURY <input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act IMMIGRATION <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 463 Habeas Corpus - Alien Detainee <input type="checkbox"/> 465 Other Immigration Actions	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 440 Other Civil Rights PRISONER PETITIONS <input type="checkbox"/> 510 Motions to Vacate Sentence Habeas Corpus: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition			

V. ORIGIN

(Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
- ☐ 2 Removed from State Court
- ☐ 3 Remanded from Appellate Court
- ☐ 4 Reinstated or Reopened
- ☐ 5 Transferred from another district (specify)
- ☐ 6 Multidistrict Litigation
- ☐ 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):

15 USC 1125

Brief description of cause:

Trademark Infringement

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No

VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

08/29/2011

s/Neal M. Cohen

FOR OFFICE USE ONLY

RECEIPT # _____ AMOUNT _____ APPLYING IFP _____ JUDGE _____ MAG. JUDGE _____

EXHIBIT C

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7 Attorneys for Defendants

8
9 **UNITED STATES DISTRICT COURT**
10 **SOUTHERN DISTRICT OF CALIFORNIA**

11 SAN PASQUAL CASINO
DEVELOPMENT GROUP, INC., an
12 enterprise fund of the San Pasqual
Band of Mission Indians, a Federally-
Recognized Indian Tribe,

13 Plaintiff,

14 v.

15 VIEJAS BAND OF KUMEYAAY
16 INDIANS, a Federally-Recognized
Indian Tribe d/b/a Viejas Casino,
17 VIEJAS ENTERPRISES, INC., a
tribal corporation of the Viejas Band
18 of Kumeyaay Indians dba Viejas
Casino, ANTHONY R. PICO,
19 Chairman of the Viejas Band of
Kumeyaay Indians; ROBERT CITA
20 WELCH, ANITA UQUALLA, SAM
Q. BROWN, GREYBUCK S.
21 ESPINOZA, VICTOR E. WOODS,
and RAYMOND BEAR CUERO,
22 Officers of the Viejas Band of
Kumeyaay Indians; CHRIS KELLEY,
23 General Manager, and VINCE
MANFREDI, Vice President of
24 Marketing, Viejas Casino

25 Defendants.

CASE NO. 11CV1983 JAH POR

**MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
MOTION TO DISMISS FILED BY
SPECIALLY-APPEARING
DEFENDANTS, VIEJAS BAND OF
KUMEYAAY INDIANS AND ITS
OFFICERS**

CASE FILED: August 29, 2011
DATE: December 12, 2011
TIME: 2:30 p.m.
COURTROOM: 11 (2nd Floor)
JUDGE: Hon. John A. Houston

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1
2 Specially-appearing Defendants, Viejas Band of Kumeyaay Indians, a
3 federally recognized Indian tribe (hereinafter the "Viejas Band" or the "Band"), also
4 erroneously sued herein as "Viejas Enterprises, Inc." (hereinafter "Viejas
5 Enterprises"), and its tribal officers, Tribal Chairman, Anthony R. Pico, Tribal
6 Council Members, Robert Cita Welch, Anita Uqualla, Sam Q. Brown, Greybuck S.
7 Espinoza, Victor E. Woods and Raymond Bear Cuero, and its casino managers,
8 Chris Kelley and Vince Manfredi (hereinafter collectively referred as the "Tribal
9 Officers") respectfully submit the following memorandum of points and authorities
10 in support of their motion to dismiss for lack of subject matter jurisdiction.

11 **I.**

12 **SUMMARY**

13 Under Federal law, Indian tribes are recognized as distinct, sovereign
14 governments which are immune from suit under the long-established doctrine of
15 tribal sovereign immunity. This doctrine is based upon the United States' strong
16 policy of protecting tribal sovereignty and promoting tribal self-governance.
17 Although a tribe may waive its immunity, such a waiver is effective only if
18 unequivocally expressed.

19 The Viejas Band owns and operates the Viejas Casino, located approximately
20 40 minutes east of San Diego in Alpine, California. "Viejas Enterprises" is an arm
21 of the Viejas Band which manages the day to day affairs of the Band's casino and
22 other businesses—it is not a separate entity. Defendant Anthony R. Pico is the
23 Chairman of the Band's Tribal Council. Defendants Robert Cita Welsch, Anita
24 Uqualla, Sam Q. Brown, Greybuck S. Espinoza, Victor E. Woods and Raymond
25 Bear Cuero are members of the Band's Tribal Council. Defendant Vince Manfredi
26 is the Vice President of Marketing for the Band's casino. Defendant Chris Kelley is
27 the General Manager of the Band's casino.
28

1 Plaintiff San Pasqual Casino Development Group, Inc. ("Plaintiff") operates
 2 Valley View Casino, located approximately 1 hour north of San Diego in Valley
 3 Center, California. In this case, Plaintiff mistakenly alleges in its First Amended
 4 Complaint (the "Complaint") that the Viejas Band's "Pinch Yourself" print
 5 advertisements and its "Are You Ready To Play?" television commercial infringe
 6 Plaintiff's alleged trademark and copyright. The Band denies these allegations.

7 In the instant motion, the Viejas Band asks the court to uphold federal law
 8 and protect its sovereignty. The Viejas Band is immune from this lawsuit under
 9 federal law, and has not waived tribal immunity in this case. Moreover, tribal
 10 immunity extends to Viejas Enterprises and its Tribal Officers. Thus, the court
 11 lacks subject matter jurisdiction. Based on the foregoing, the Band respectfully
 12 requests that the court grant this motion and dismiss all claims against the Band,
 13 Viejas Enterprises and the Tribal Officers, pursuant to FRCP 12(b)(1).

14 II.

15 FACTS

16 The Viejas Band is a federally-recognized Indian tribe residing on a
 17 reservation in San Diego County. (Complaint, ¶7.) The Band is identified on the
 18 Federal Register listing of federally-recognized tribes as the Capitan Grande Band
 19 of Diegueno Mission Indians of California: Viejas (Baron Long) Group of Capitan
 20 Grande Band of Mission Indians of the Viejas Reservation, California. See
 21 accompanying Declaration of Anthony R. Pico ("Pico Decl."), ¶2, and the Federal
 22 Register listing, **Exhibit A** to the accompanying Request for Judicial Notice.

23 The Tribal Council is the governing body of the Band. (Pico Decl., ¶ 3.) The
 24 Band established Viejas Enterprises to promote the Band's general welfare by
 25 managing the day to day affairs of Band's casino and other business interests.
 26 Viejas Enterprises is an arm of the Band—it is not incorporated or otherwise
 27 organized under the laws of any state. (Pico Decl., ¶ 4).

Defendants Robert Cita Welsh, Anita Esqualla, Sam Q. Brown, Greybuck S. Espinoza, Victor E. Woods, and Raymond Cuero are members of the Viejas Tribal Council. (Complaint, ¶10.) Defendant Vince Manfredi is Vice President of Marketing for Viejas Casino. (Complaint, ¶11.) Defendant Chris Kelley is the General Manager of Viejas Casino. (Complaint, ¶12.) ***Each of the individual defendants is being sued in this case for acts, practices, or conduct “carried out in his or her official capacity.”*** (Complaint, ¶13.)

The Band has not waived its sovereign immunity related to the events or parties at issue in this lawsuit. (Pico Decl., ¶ 5.)

III.

DISCUSSION

A. Rule 12(b)(1) Motion to Dismiss

“A motion to dismiss for lack of subject matter jurisdiction may either attack the allegations of the complaint or may be made as a ‘speaking motion’ attacking the existence of subject matter jurisdiction in fact.” *Thornhill Publishing Co. v. General Tel & Elect.*, 594 F.2d 730, 733 (9th Cir. 1979); see also Fed. R. Civ. P. 12(b)(1). “Unlike a Rule 12(b)(6) motion, a Rule 12(b)(1) motion can attack the substance of a complaint’s jurisdictional allegations despite their formal sufficiency, and in doing so rely on affidavits or any other evidence properly before the court.” *St. Clair v. City of Chico*, 880 F.2d 199, 201 (9th Cir. 1989). Thus, the existence of disputed material facts will not preclude the trial court from evaluating for itself the merits of jurisdictional claims. *Id.*

Where the defendant brings the motion as a “speaking motion” presenting a factual challenge to subject matter jurisdiction, the Court may consider extrinsic evidence on whether jurisdiction exists and may resolve factual disputes if necessary. *Thornhill*, 594 F.2d at 733. Because the plaintiff bears the burden of establishing subject matter jurisdiction, no presumption of truthfulness attaches to the allegations of plaintiff’s complaint and the Court must presume it lacks

jurisdiction until plaintiff establishes jurisdiction. *Kokkonen v. Guardian Life Ins. Co. of America*, 511 U.S. 375, 377, 114 S.Ct. 1673, 1675 (1994); and *Stock West, Inc. v. Confederated Tribes*, 873 F.2d 1221, 1225 (9th Cir. 1989).

An objection to subject matter jurisdiction based upon sovereign immunity may be asserted by the parties at any time or by the court *sua sponte*. *Pitt River Home and Agricultural Cooperative Association v. United States*, 30 F.2d 1088, 1100 (9th Cir. 1994). Based on the foregoing, this motion to dismiss is procedurally sound and proper.

B. The Viejas Band is a Federally Recognized Indian Tribe

The Viejas Band is a federally recognized Indian tribe. See Complaint, ¶7; and **Exhibit A** to the Req. for Jud. Notice (Federal Register listing of tribes).

C. The Court lacks jurisdiction over the Viejas Band

“Suits against Indian tribes are ... barred by sovereign immunity absent a clear waiver by the tribe or congressional abrogation.” *Oklahoma Tax Comm'n v. Citizen Band Potawatomi Indian Tribe*, 498 U.S. 505, 509 (1991); *Snow v. Quinault Indian Nation*, 709 F.2d 1319, 1321 (9th Cir.1983). Tribal sovereign immunity deprives a court of subject matter jurisdiction. See *Pitt River Home & Ag. Coop. Ass'n v. United States*, 30 F.3d 1088, 1100 (9th Cir.1994); *Pan Am. Co. v. Sycuan Band of Mission Indians*, 884 F.2d 416, 418 (9th Cir.1989). “There is a strong presumption against waiver of tribal sovereign immunity.” *Demontiney v. U.S. ex rel. Dept. of Interior, Bureau of Indian Affairs*, 255 F.3d 801, 811 (9th Cir. 2001). Waiver of sovereign immunity by a tribe must be unequivocally expressed and may not be implied. *Kescoli v. Babbitt*, 101 F.3d 1304, 1310 (9th Cir.1996); *Quileute Indian Tribe v. Babbitt*, 18 F.3d 1456, 1459 (9th Cir.1994); *McClendon v. United States*, 885 F.2d 627, 629 (9th Cir.1989); *Snow*, 709 F.2d at 1321. ***Similarly, congressional abrogation of sovereign immunity may not be implied and must be “unequivocally expressed” in “explicit legislation.”*** *Krystal Energy Co. v. Navajo Nation*, 357 F.3d 1055, 1056 (9th Cir.2003); *Demontiney*, 255 F.3d at

1 811. Plaintiffs bear the burden of demonstrating there was an express and
 2 unequivocal waiver of tribal sovereign immunity. See *Baker v. United States*, 817
 3 F.2d 560, 562 (9th Cir.1987); *Breakthrough Mgmt. Group, Inc. v. Chukchansi Gold*
 4 *Casino & Resort*, 2007 WL 2701995 *2 (D.Colo.2007). Absent an express and
 5 unequivocal waiver of immunity by the tribe or abrogation of tribal immunity by
 6 Congress, tribes cannot be sued. *Stock West Corp. v. Lujan*, 982 F.2d 1389, 1398
 7 (9th Cir.1993).

8 Tribal sovereign immunity applies in both federal and state courts. See *Santa*
 9 *Clara Pueblo v. Martinez*, 436 U.S. 49, 68 (1978); *Puyallup Tribe, Inc. v.*
 10 *Department of Game of Washington*, 433 U.S. 165, 171-73 (1977); *Snow*, 709 F.2d
 11 at 1321; *United States v. Oregon*, 657 F.2d 1009, 1012-13 (9th Cir.1981). “The
 12 immunity ... extends to suits for declaratory and injunctive relief,” and “is not
 13 defeated by an allegation that [the tribe] acted beyond its powers.” *Imperial*
 14 *Granite Co. v. Pala Band of Mission Indians*, 940 F.2d 1269, 1271 (9th Cir.1991).
 15 Tribal sovereign immunity is not dependent on a distinction between on-reservation
 16 and off-reservation conduct nor upon a distinction between the governmental and
 17 commercial activities of a tribe. *Kiowa Tribe v. Manufacturing Techs.*, 523 U.S.
 18 751, 754-55, 759-60 (1998); *Allen v. Gold Country Casino*, 464 F.3d 1044, 1046
 19 (9th Cir. 2006); *American Vantage Cos. v. Table Mt. Rancheria*, 292 F.3d 1091,
 20 1100 (9th Cir.2002); *Bassett v. Mashantucket Pequot Tribe*, 204 F.3d 343, 357 (2d
 21 Cir.2000) (Bassett I). A tribe’s sovereign immunity extends both to tribal
 22 governing bodies and to tribal agencies which act as an arm of the tribe. See *Allen*,
 23 464 F.3d at 1046; see also *Marceau v. Blackfeet Hous. Auth.*, 455 F.3d 974, 978
 24 (9th Cir.2006); *Pink v. Modoc Indian Health Project*, 157 F.3d 1185, 1188 (9th
 25 Cir.1998). Thus, it is irrelevant whether the particular tribal entity is conducting
 26 business activities because the appropriate question is whether the particular “entity
 27 acts as an arm of the tribe so that the entity’s activities are properly deemed to be
 28 those of the tribe.” *Allen*, 464 F.3d at 1046.

As the Ninth Circuit recognized in *Shermoen v. United States*, the proper enforcement of tribal immunity from suit will often deprive a claimant a forum in which to have some of its grievances heard. Such results simply show that "Congress' authority over Indian matters is extraordinarily broad, and the role of courts in adjusting relations between and among tribes and their members correspondingly restrained." *Shermoen v. United States*, 982 F.2d 1312, 1320-21 (9th Cir. 1992), quoting *Santa Clara Pueblo v. Martinez*, 436 U.S. 49, 72, 56 L. Ed. 2d 106, 98 S. Ct. 1670 (1978).

D. The Band Is Immune from Plaintiff's Intellectual Property Claims

Tribal immunity applies equally to intellectual property claims. At least three courts have examined whether tribes are subject to suit for infringement of copyrights and patents, and all three have answered in the negative. See *Bassett I, supra*, 204 F.3d at 357 (holding that "nothing on the face of the Copyright Act purports to subject tribes to jurisdiction of the federal courts in civil actions brought by private parties ... and a congressional abrogation of tribal immunity cannot be implied"); *Multimedia Games, Inc. v. WLGC Acquisition Corp.*, 214 F. Supp. 2d 1131, 1135 (N.D. Okla. 2001) ("Where the language of a federal statute does not explicitly assert jurisdiction over tribal entities or implicitly by including tribes in the definition of parties subject to the suit, courts find the language insufficient to express an unequivocal congressional abrogation of tribal sovereign immunity . . . this Court finds that the text of the Copyright Act of 1976 and the accompanying legislative history of the statute did not affirmatively contemplate the inclusion of Indian tribes"); and *Home Bingo Network v. Multimedia Games, Inc.*, No. 05 Civ. 0608, 2005 U.S. Dist. LEXIS 34238 (N.D.N.Y. Aug. 30, 2005). See also *Frazier v. Turning Stone Casino*, 254 F.Supp. 2d 295, 307-310 (N.D.N.Y. 2003) (held that plaintiff could not maintain an action against the tribal defendants for misappropriation of plaintiff's image and likeness for advertising purposes).

Moreover, although Congress passed the Copyright Remedy Clarification Act in 1990 which attempted to extend liability under the Copyright Act to states, or any instrumentality of a state, and any officer or employee of a state, acting in his or her official capacity, declaring that such persons shall not be immune under the Eleventh Amendment to the Constitution from copyright claims (17 U.S.C. § 511), *Congress has not attempted to extend liability under the Copyright Act to Indian tribes and its officers*. Indeed, Congress passed the Copyright Remedy Clarification Act in response to circuit court rulings, including a Ninth Circuit ruling, which held that there is no language in Copyright Act of 1976 indicating any intent to subject states to suit in federal court for copyright infringement. See, e.g., *BV Engineering v University of California*, 858 F.2d 1394, 8 USPQ2d 1421 (9th Cir. 1988), *cert den* (1989) 489 US 1090, 103 L Ed 2d 859, 109 S Ct 1557. Thus, it is clear under Ninth Circuit case law that sovereign entities will not be liable for copyright infringement, unless and until Congress passes a statute stating so. To date, Congress has not done so with Indian tribes.

In all events, as stated in the previous section, ***congressional abrogation of sovereign immunity may not be implied and must be “unequivocally expressed” in “explicit legislation.”*** *Krystal Energy Co. v. Navajo Nation*, 357 F.3d 1055, 1056 (9th Cir.2003); *Demontiney*, 255 F.3d at 811. See also *Santa Clara Pueblo*, 436 U.S. at 58, 98 S.Ct. at 1676 (holding that a waiver of sovereign immunity may not be implied, but must be unequivocally expressed).

Again, in this case, Plaintiff admits in its Complaint that the Viejas Band is a federally-recognized Indian tribe. (Complaint, ¶6.) Moreover, Plaintiff does not even allege that the Band has waived its immunity from suit in this case or that congress has abrogated the Viejas Band's immunity. Rather, it summarily asserts that the court has subject matter jurisdiction pursuant to 15 U.S.C. §1121 and 28 U.S.C. §§1331, 1338(a), and 1362—none of which diminish, rescind or otherwise weaken the Viejas Band's immunity from suit. All of these statutes are general,

jurisdictional statutes which do not mention tribal immunity. Only 28 U.S.C. §1362 mentions Indian tribes—but it certainly does not rescind or diminish tribal immunity. See *Scholder v. United States*, 428 F.2d 1123 (9th Cir. 1970) (“The purpose of section 1362 was to eliminate the \$10,000 jurisdictional requirement of 28 U.S.C. §1331 for a particular class of suits, namely, federal-question actions brought by an Indian tribe or band. [Citation omitted.] Nothing on the face of section 1362 indicates an intention by Congress to waive sovereign immunity, and we know nothing in its legislative history to suggest such a purpose”) *cert. denied* 400 U.S. 942 (1970); and *W. Shoshone National Council v. United States*, 408 F.Supp.2d 1040 (D. Nev. 2005).

For these reasons, it is beyond dispute that the Band is immune from suit.

E. Sovereign immunity extends to Viejas Enterprises and the Tribal Officers.

A tribe’s sovereign immunity extends both to tribal governing bodies and to tribal agencies which act as an arm of the tribe, as well as to agents of an Indian tribe acting in their representative capacity and within the scope of their authority. *Allen*, 464 F.3d at 1046; *Pink v. Modoc Indian Health Project*, 157 F.3d 1185, 1188 (9th Cir.1998); *Linneen v. Gila River Indian Community*, 276 F.3d 489, 492 (9th Cir.2001); *Hardin v. White Mountain Apache Tribe*, 779 F.2d 476, 479 (9th Cir.1985); *Snow*, 709 F.2d at 1322. ***Tribal sovereign immunity extends to employees of a tribe acting within the scope of their authority.*** *Cook v. Avi Casino Enterprises, Inc.*, 548 F.3d 718, 727(9th Cir.2008). ***Where plaintiffs allege no viable claim that tribal officials acted outside their authority, tribal immunity applies.*** See *Imperial Granite Co. v. Pala Band of Mission Indians*, 940 F.2d 1269, 1271 (9th Cir.1991). The commission of a tort is not per se an act in excess of authority. See, e.g., *Larson v. Domestic & Foreign Commerce Corp.*, 337 U.S. 682, 682-688 (1949); see also *Trudgeon v. Fantasy Springs Casino*, 71 Cal.App.4th 632, 644 (1999).

1 Indeed, the Ninth Circuit in a unanimous decision recently confirmed that
 2 tribal immunity extends tribal employees acting within the scope of their authority.
 3 In *Cook, supra*, the Ninth Circuit reaffirmed that, in these cases the sovereign entity
 4 is the “real, substantial party in interest and is entitled to invoke its sovereign
 5 immunity from suit even though individual officers are nominal defendants” and
 6 that that sovereign immunity cannot be avoided by simply naming employees of the
 7 sovereign as defendants. *Cook, supra*, 548 F.3d at 727, citing *Regents of the*
 8 *University of California v. Doe*, 519 U.S. 425, 429 (1997).

9 Likewise, in *Frazier v. Turning Stone Casino*, 254 F.Supp. 2d 295, 307-310
 10 (N.D.N.Y. 2003), relying upon well-established precedent and after careful
 11 consideration, the District Court held that tribal immunity extended to all tribal
 12 employees acting within their representative capacity and within the scope of their
 13 authority, such that the plaintiff could not pursue claims against the individual
 14 employees of the tribe.

15 In this case, *Plaintiff admits that the "Individual Defendants" are being*
 16 *suing for "acts, practices, or conduct carried out in his or her official capacity."*
 17 (Complaint, ¶13.) Based on the foregoing, it is beyond dispute that the Tribal
 18 Officers are immune from Plaintiff's claims in this case.

19 **F. Plaintiff's assertion that it may proceed with its claims against the**
 20 **Individual Defendants under the *Ex Parte Young* doctrine is incorrect.**

21 Plaintiff will incorrectly argue that even if the Viejas Band is immune, that
 22 Plaintiff can still seek injunctive relief against the Tribal Officers because, so the
 23 argument goes, immunity does not bar suit for prospective relief against tribal
 24 officials. Citing, *Burlington & Santa Fe RY, Co. v. Vaughn*, 509 F.3d 1085, 1092
 25 (9th Cir. 2007); *Rogers-Dial v. Rincon Band of Luiseno Indians*, No. 10CV2656-
 26 WQH-POR, 2011 WL 2619232 (S.D. Cal. July 1, 2011); and *Bassett v.*
 27 *Masshantucket Pequot Museum & Research Ctr.*, 221 F.Supp.2d 271 (D.Conn.
 28 2002) (*Bassett II*). This argument should be rejected, as discussed below.

1 First, the *Bassett II* case does not support Plaintiff's position. There, the
2 officers of the Mashantucket Pequot Museum & Research Center incorrectly
3 admitted (for some unstated reason) that (1) prospective injunctive relief was
4 available against them, (2) the copyright act substantively applied to the tribal
5 agency at issue and (3) plaintiffs had a private right of action against the agency.
6 See, *Bassett II*, 221 F.Supp.2d at 279 and n. 12. Thus, *Bassett II* cannot be cited as
7 authority for the proposition that prospective injunctive relief is available against
8 tribal officers for copyright infringement *because that issue was not litigated by the*
9 *parties or decided by the court in that case.*

10 Second, the other cases cited by Plaintiff (*Vaughn* and *Rogers-Dial*) are
11 clearly distinguishable from the instant case. "The language of an opinion must be
12 construed with reference to the facts presented by the case; the positive authority of
13 a decision is coextensive only with such facts." *Lolley v. Campbell*, 28 Cal. 4th
14 367, 377 (2002). In *Vaughn*, the tribal officers were incorrectly attempting to
15 collect the Hualapai Tribe's possessory interest tax against the plaintiff railroad for
16 use of the railroad's right-of-way through the reservation. And in *Rogers-Dial*, the
17 tribal officers incorrectly placed concrete barriers in front of the plaintiff's
18 residence to block them from accessing their property. No such facts exist in this
19 case. Indeed, the Viejas Band's officers are not using their governmental authority
20 to interfere with Plaintiff in any way. Rather, Plaintiff is incorrectly attempting to
21 dictate to the Viejas Band how it conducts its business.

22 Finally, the great weight of authority discussed above clearly shows that the
23 Band is immune from Plaintiff's copyright and trademark claims. As a result, the
24 Tribal Officers must likewise be immune for those claims, especially given that
25 Plaintiff admits that Tribal Officers were acting in their official capacity. To rule
26 otherwise would put form above substance.

27 For the foregoing reasons, Plaintiff's reliance upon the *Ex Parte Young*
28 doctrine is misplaced.

IV.

CONCLUSION

For the foregoing reasons, the Viejas Band respectfully requests that the court grant this motion and dismiss the claims against the Viejas Band, Viejas Enterprises, and the Tribal Officers.

DATED: November 7, 2011

HIGGS, FLETCHER & MACK LLP

By: /s/ Phillip Samouris
PHILLIP C. SAMOURIS
Attorneys for Defendants

EXHIBIT D

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7 Attorneys for Defendants

8
9 UNITED STATES DISTRICT COURT
10 SOUTHERN DISTRICT OF CALIFORNIA

11 SAN PASQUAL CASINO
DEVELOPMENT GROUP, INC., an
enterprise fund of the San Pasqual Band of
12 Mission Indians, a Federally-Recognized
Indian Tribe,

13 Plaintiff,

14 v.

15 VIEJAS BAND OF KUMEYAAY
INDIANS, a Federally-Recognized Indian
16 Tribe d/b/a Viejas Casino, et. al.,

17 Defendants.

CASE NO. 11CV1983 JAH POR

**DECLARATION OF VINCE
MANFREDI IN SUPPORT OF
DEFENDANT'S EX PARTE
APPLICATION FOR ORDER
STAYING OR CONTINUING THE
HEARING ON PLAINTIFF'S
MOTION FOR PRELIMINARY
INJUNCTION PENDING
DETERMINATION OF SUBJECT
MATTER JURISDICTION**

CASE FILED: August 29, 2011
COURTROOM: 11 (2nd Floor)
JUDGE: Hon. John A. Houston

19 I, Vince Manfredi, declare as follows:

20 1. I am the Vice President of Marketing for Viejas Casino. As of the date
21 of this declaration, Viejas Casino is not running the "Pinch Yourself" print
22 advertisements and the "Are You Ready To Play?" television commercial which are
23 the subject of Plaintiff's complaint in this case. Viejas Casino does not presently
24 plan to restart those advertisements, although it may do so in the future.

25 I declare under penalty of perjury that the foregoing is true and correct.

26 Executed this 3rd day of November, 2011, at Alpine, California

27 
VINCE MANFREDI
28

EXHIBIT E

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2 Marger Johnson & McCollom PC

3 210 SW Morrison St., Suite 400

4 Portland, Oregon 97204

5 Tel: (503) 222-3613

6 Attorneys for Plaintiff

7
8 **UNITED STATES DISTRICT COURT**
9 **SOUTHERN DISTRICT OF CALIFORNIA**

10 SAN PASQUAL CASINO DEVELOPMENT
11 GROUP INC., an enterprise fund of the San
12 Pasqual Band of Mission Indians, a Federally-
13 Recognized Indian Tribe,

14 Plaintiff,

15 vs.

16 VIEJAS BAND OF KUMEYAAY INDIANS,
17 a Federally-Recognized Indian Tribe d/b/a
18 Viejas Casino;

19 VIEJAS ENTERPRISES, INC., a tribal
20 corporation of the Viejas Band of Kumeyaay
21 Indians d/b/a Viejas Casino;

22 ANTHONY R. PICO, Chairman of the Viejas
23 Band of Kumeyaay Indians;

24 ROBERT CITA WELCH, ANITA
25 UQUALLA, SAM Q. BROWN, GREYBUCK
S. ESPINOZA, VICTOR E. WOODS, and
RAYMOND BEAR CUERO, Officers of the
Viejas Band of Kumeyaay Indians;

CHRIS KELLEY, General Manager, and
VINCE MANFREDI, Vice President of
Marketing, Viejas Casino;

Defendants.

Civil Action No. '11 CV1983 JAH POR

NOTICE OF VOLUNTARY DISMISSAL
PURSUANT TO FED. R. CIV. P. 41

1 In view of the Manfredi Declaration (Dkt. #14-1) indicating cessation of use of the
2 PINCH YOURSELF mark and the Viejas Commercial, Plaintiff San Pasqual Casino
3 Development Group Inc. ("SPCDG") hereby dismisses this action, without prejudice, as to all
4 Defendants pursuant to Fed. R. Civ. P. 41(a)(1)(A)(i). No Defendant has yet answered or filed a
5 motion for summary judgment.

6 Dated this 14th day of December, 2011.

7
8 Respectfully,

9 **MARGER JOHNSON & MCCOLLOM PC**

10 By: /s/ Hillary A. Brooks
11 Hillary A. Brooks, OSBA No. 012138
12 210 SW Morrison St., Suite 400
Portland, Oregon 97204
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13 **VISTA IP LAW GROUP LLP**

14 Neal M. Cohen, CSBA No. 184978
15 2040 Main Street, Suite 710
Irvine, California 92614

16 *Attorneys for Plaintiff*

**SAN PASQUAL CASINO DEVELOPMENT
GROUP INC.**

CERTIFICATE OF SERVICE

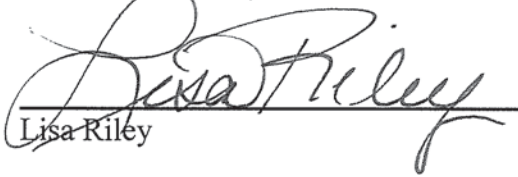
I hereby certify that I served a copy of the foregoing **NOTICE OF VOLUNTARY DISMISSAL PURSUANT TO FED. R. CIV. P. 41**

on:

Phillip C. Samouris
HIGGS FLETCHER & MACK
401 West A Street, Suite 2600
San Diego, California 92101

by transmitting full, true, and correct copies thereof to the attorneys through the Court's CM/ECF system on the date set forth below;

Dated this 14th day of December, 2011.


Lisa Riley